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IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-1692

FAMOLARE, INC.,

Petitioner,

vs.

EDISON BROTHERS STORES, INC. AND USM CORP.,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

The petitioner Famolare, Inc. respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit in the above-entitled cause.

OPINIONS BELOW.

The unpublished *per curiam* Order of the Court of Appeals appears in the Appendix hereto (A 1 to A 14). It affirmed the judgment of the District Court for the Northern District of Illinois, Eastern Division, Judge Hubert L. Will presiding, reported at 202 U. S. P. Q. 373 and included in the Appendix (A 15 to A 50).

JURISDICTION.

The judgment of the Court of Appeals was entered January 30, 1980. A timely petition for rehearing *en banc* was denied on February 29, 1980 and this petition for certiorari was filed within 90 days of that date. The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1). The basis of jurisdiction in the District Court was 28 U. S. C. §§ 1338(a) and 2201.

QUESTION PRESENTED.

Whether the Seventh Circuit's conditions for patentability of ornamental designs under 35 U. S. C. § 171, including that a design must reflect "creative originality in artistry," afford a correct determination of the "non-obviousness" requirement of 35 U. S. C. § 103 for design inventions and are consistent with this Court's decisions in *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966) and *Gorham Mfg. Co.* v. *White*, 81 U. S. 511 (1872).[1]

STATUTES INVOLVED.

United States Code, Title 35:

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

1. The Court of Appeals also affirmed the invalidation of Famolare utility patent 3,936,956 for claim indefiniteness under 35 U. S. C. § 112. The utility patent is directed to resilient, shock-absorbing soles having the same overall shape as that of the design patent. While not urged as a basis for granting certiorari, the petitioner requests the right to raise a sharply-defined question of applying a rule of law of *United States* v. *Adams*, 383 U. S. 39 (1966) to the utility patent claims. The petitioner presented and discussed this issue in its petition for rehearing below. It is prepared to submit copies of that 10 page petition for consideration herein should this Court so desire.

at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

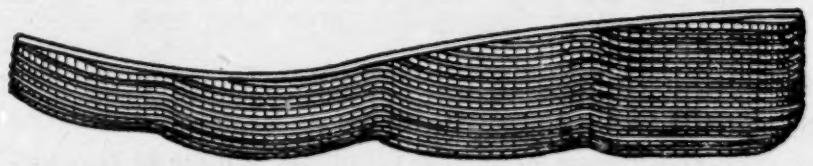
§ 171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

STATEMENT OF THE CASE.

Design patent D-235,701 is directed to the specific ornamental design of the four-wave or four-crested "Get There" shoe sole marketed by the petitioner company, Famolare, Inc. Figure 4 of the design patent is reproduced below:



The design patent, by law (37 C. F. R. § 1.153), has a single formalistic claim directed to "The ornamental design of a shoe sole, substantially as shown and described."

The inventor, Joseph P. Famolare, Jr., founded the petitioner company in 1969. In 1974 Famolare, Inc. introduced its "Get There" line of shoes embodying the patented soles. During the four year period between their introduction and the trial in the district court, shoes having the patented "Get There" sole proved to be the best selling and most widely copied among many of the nation's largest independent shoe retailers—including one who initially viewed it as "a real turkey," buying it only because of Famolare's reputation and urging (A 37-40). Reflecting what the district court termed "almost meteoric commercial success"

(A 39), Famolare, Inc., which had been a 12 million dollar company in 1973, sold 30 million dollars worth of "Get There" shoes alone in 1978 (A 23).

Respondent USM Corp., parent of what was formerly the United Shoe Machinery Corp., and having revenues in the footwear industry alone of over 267 million dollars in 1974,[2] copied the "Get There" sole shortly after its introduction. Subsequently, USM Corp. sold millions[3] of pairs of the copied soles to some 55 shoe manufacturers and sellers which it indemnified from claims of infringement by Famolare, Inc. (A 34). Among those indemnitees was respondent Edison Brothers Stores, Inc., which had footwear sales of 442 million dollars in 1979.[4]

The trial court found the shoe sole to be:

—"the most attractive"

—"the most successful"

—"the most widely copied"

—"the best wavy sole design developed to date" (A 39-40)[5]

and to have crest placement "not obvious to any designer including Famolare." (A 45)

The trial court additionally found that while certain individual features of the Famolare shoe sole "in general terms are not new to shoe sole design . . . the effect or appearance of the Famolare four wave sole is different than any of the prior art." (A 38)[6] None of the prior art examples was a commercial success (A 30).

2. USM Corporation Annual Report 1974.

3. The actual number of soles sold has been withheld by USM as proprietary information.

4. Footwear News, April 7, 1980, at 40, cols. 4 and 5.

5. Other judgments on the "Get There" shoe include its selection for the permanent collections of the Metropolitan Museum of Art and the Cincinnati Museum of Art.

6. Photographs of the "Get There" sole and the seven asserted prior art soles are included in the Appendix (A 51). For comparison, Plaintiff's Trial Exhibit 586, also reproduced in the Appendix (A 52), includes pictures of 14 shoes and shoe soles manufactured and sold by the respondents.

The trial court held the four wave design patent invalid as "lack[ing] invention over the prior art and reflect[ing] no creative originality or artistry" and on the basis that "it would have been obvious to a designer of ordinary skill to design soles with three, four, five or more waves." (A 32)

The Court of Appeals for the Seventh Circuit summarized the facts found by the trial court. It affirmed the trial court's conclusions of law, stating that the test of creative originality in artistry "has long been a hallmark for considering the question of invention in this Circuit." (A 8) As to the trial court's holding of obviousness, the court of appeals stated, "Judge Will was in literal compliance with the *Graham* procedure." (A 10) The court noted "the success of the 'Get There' shoe is simply too weak a reed upon which to rest a claim of invention or non-obviousness for the Famolare four-wave sole." (A 11)

REASONS FOR GRANTING THE WRIT.

No design patent has been considered by this Court since 1893.[7] As a consequence, the law of patentability of ornamental designs is in total disarray.[8] The design statute has been twice

7. *Smith* v. *Whitman Saddle Co.*, 148 U. S. 674 (1893).

8. In 1960 Judge Rich of the U. S. Court of Customs and Patent Appeals offered the following commentary on the state of the law pertaining to design patents:

> This committee will appreciate the major problem this law presents if it will attempt in its own mind to figure out how, as a court, it would go about determining that any given completed ornamental design would be unobvious to a designer, or would involve invention.
>
> Add to this the many adjudications, including those of my own court, that the so-called standard of invention is the same for design inventions as it is for all others, engines, chemical compounds, processes, and radio circuits. The situation is, and always has been, anomalous and very difficult to obtain and more difficult to sustain and many have felt it was not worth the effort and the protection illusory.

Design Protection: Hearings Pursuant to S. Res. 240 on S. 2075 and S. 2852 Before the Subcomm. on Patents, Trademarks, and Copy-

(Footnote continued on next page.)

amended by Congress in the interim, most recently in the Patent Act of 1952. That same Patent Act introduced 35 U.S.C. § 103, the non-obviousness requirement for *all* patents, considered in depth by the Court in *Graham* in the context of utility patents.

Design patents have been singularly ill-treated by the Seventh Circuit Court of Appeals. Since 1937 (44 years after this Court's last word on design patents) every single design patent coming before that court has been held invalid. The instant case

(Footnote continued from preceding page.)
rights, of the Senate Comm. on the Judiciary, 86th Cong. 2d Sess. 51 (1960).

In addition, numerous writers have considered the uncertainties, inequities and inadequacies in the design patent system as it has been applied by the courts. Among these commentaries are: Michaelson, *Design Patents and Obviousness—Obviousness to Whom?,* 52 J. PAT. OFF. SOC'Y 620 (1970); Comment, *Design Protection—Time to Replace the Design Patent,* 51 MINN. L. REV. 942 (1967); Dulin, *Statutory Design Rights: Solution to the Unfair Competition of Piracy,* 34 GEO. WASH. L. REV. 110 (1965); Mott, *Standard of Ornamentality in the Design Patent Law,* 48 A. B. A. J. 548, 643 (1962); Sokolski, *Is Our Design Patent Statute Adequate?* 42 J. PAT. OFF. SOC'Y 496 (1960); *Design Patents and Copyrights: The Present Inadequate State of the Law,* 32 S. CAL. L. REV. 188 (1959).

Consistent with suggestions in the above articles, the need for supplementation and/or revision of the law pertaining to design protection has periodically been the subject of consideration by both houses of Congress for 20 years. *See generally* the hearings referenced above and the subsequent hearings, *Design Protection: Hearings Pursuant to S. Res. 55 on S. 1884 Before the Subcomm. on Patents, Trademarks and Copyrights of the Senate Comm. on the Judiciary,* 87th Cong., 1st Sess. 1-220 (1961). A pending bill in the House, H. R. 4530, 96th Cong., 1st Sess. (1980), entitled "Design Protection Act of 1980" would amend the copyright law, title 17 of the United States Code, to provide, in addition to design patents as they presently exist, copyright-like registration protection for certain ornamental designs of useful articles (though specifically *excluding* wearing apparel). Commentaries on such an approach include the following: Comment, *Dual Copyright and Design Patent Protection: Works of Art and Ornamental Designs,* 49 ST. JOHN'S L. REV. 543 (1975); Note, 21 WAYNE L. REV. 1239 (1975); *Design Protection,* 15 COPYRIGHT L. SYM. (ASCAP) 76 (1967).

runs the unbroken string to 28 design patent invalidity holdings.[9] This is not to say that design patents have fared well in the circuit courts generally. At last count, for all circuits since 1948, 64 of 74 (86%) of the design patents adjudicated have been held invalid.[10] But the mortality rate has become statistically certain death in the Seventh Circuit.

The superlatives of the trial court below in describing the shoe sole of the design patent demonstrates that the experienced trial

9. In 1960 the Seventh Circuit summarized its record on design patents in *Amerock Corp.* v. *Aubrey Hardware Mfg. Inc.,* 275 F. 2d 346, 349 n. 1 (7th Cir. 1960). The compilation shows that between 1937 and the *Amerock* decision the court had held 20 design patents invalid. The *Amerock* decision itself affirmed a holding that a design patent on a drawer pull was invalid for lack of invention. Six subsequent decisions prior to the present case were: *Vollrath* v. *Premium Plastics, Inc.,* 385 F. Supp. 843, *aff'd mem.,* 513 F. 2d 636 (7th Cir. 1975) (bed pan, invalidity affirmed); *L. F. Strassheim Co.* v. *Gold Medal Folding Furniture Co.,* 477 F. 2d 818 (7th Cir. 1973) (folding chair, validity reversed); *Frantz Mfg. Co.* v. *Phenix Mfg. Co.,* 457 F. 2d 314 (7th Cir. 1972) (overhead garage door, validity reversed); *Stiffel Co.* v. *Sears, Roebuck and Co.,* 313 F. 2d 115 (7th Cir. 1963) (pole lamps, invalidity affirmed), *rev'd on other grounds,* 376 U. S. 225 (1964); *Day-Brite Lighting, Inc.* v. *Compco Corp.,* 311 F. 2d 26 (7th Cir. 1963) (fluorescent lighting fixtures, invalidity affirmed), *rev'd on other grounds,* 376 U. S. 234 (1964); and *Day-Brite Lighting, Inc.* v. *Sandee Mfg. Co.,* 286 F. 2d 596 (7th Cir. 1960) (panel of lighting fixtures, validity reversed).

10. First Circuit: all of 7 design patents adjudicated since 1948 held invalid;
Second Circuit: 13 of 14 held invalid;
Third Circuit: 7 of 11 held invalid;
Fourth Circuit: 1 of 2 held invalid;
Fifth Circuit: 1 of 2 held invalid;
Sixth Circuit: 4 of 5 held invalid;
Seventh Circuit: all of 18 held invalid;
Eighth Circuit: one held invalid;
Ninth Circuit: 10 of 11 held invalid;
Tenth Circuit: 1 of 2 held invalid; and
D. C. Circuit: one held invalid.

(The information above for circuits other than the Seventh was taken from Cohen, *Nonobviousness and the Circuit Courts of Appeals—Twenty-five Years in Review, BNA 1977 Patent Law Conference Coursebook,* pp. 3:14 to 3:51, as updated by the petitioner.)

judge recognized that something about the petitioner's design set it apart from any and all prior art designs. His error was one of law. Of the two competing sets of conditions before him for judging patentability of ornamental designs—that of the Supreme Court and that of the Seventh Circuit—he chose to apply the home-grown one.

The petitioner urged the trial court to adhere to the principles set forth by this Court in its *Gorham* and *Graham* decisions, *supra,* recently applied in the context of design patents under 35 U. S. C. § 103 by the Second and the Sixth Circuits.[11] That is, a design must ultimately be evaluated in terms of its overall aesthetic effect, its *tout ensemble,* with commercial success and widespread copying being significant indicia of the unobviousness of a design. Even before the *Graham* decision in 1966 this same approach under Section 103 had been adopted by the Third, Fifth and Ninth Circuits.[12]

Respondents, on the other hand, urged the trial court to apply the Seventh Circuit's own condition for design patentability, "creative originality in artistry," established by the Seventh Circuit in 1940 in *Battery Patents Corp.* v. *Chicago Cycle Supply Co.*, 111 F. 2d 861, 862 (7th Cir. 1940). They further argued that the individual *elements* of the design, as opposed to its *tout ensemble,* must be the focus, with the commercial success and copying being irrelevant.

The trial court succinctly stated in its conclusion as to the petitioner's proposed conditions for patentability, "If difference in appearance from the prior art, commercial success and widespread imitation and copying add up to invention, the Famolare design patent is valid." (A 38) But the trial court felt its hands were tied; it could not depart from the Seventh Circuit's own forty-year-old condition for patentability, conclusively demon-

11. The *Lancaster* (2d Cir. 1974) and *Schnadig* (6th Cir. 1974) cases are discussed below at p. 16.

12. The *Palmer* (3d Cir. 1956), *Sel-O-Rak* (5th Cir. 1956) and *Brown* (9th Cir. 1957) cases are discussed below at pp. 15-16.

strated to be unattainable by the unblemished record of design patent invalidations since its adoption:

> If, however, a design patent to be valid must reflect "creative originality in artistry" (*Amerock Corp.* v. *Aubrey Hardware Mfg., Inc.*, . . . [275 F. 2d 346, 348 (7th Cir. 1960)]) it can hardly be contended that the Famolare wavy soles represent a revolutionary concept in shoe sole design. (A 38)
>
> * * *
>
> Given the present state of the patent law, the relevant prior art and the relative variation thereof reflected in plaintiff's patent, we conclude that while the plaintiff's four wave "Get There" sole is the best wavy shoe sole design developed to date, has been an outstanding commercial success, and has been widely copied by a number of competitors including defendants, it does not represent such an inventive contribution to the public or such a meaningful advance in the shoe design art that it constitutes invention. (A 40)

Thus the trial court felt compelled to invalidate the patent on the sole design which it found to be the "best" and the "most" of all an ornamental design is supposed to be, and *valid* under the conditions for patentability which petitioner urges are the proper ones.

The Seventh Circuit affirmed the trial court, hailing "creative originality in artistry" as a "hallmark for considering the question of invention in . . . [the Seventh] Circuit." (A 8) Until this unattainable "hallmark" is abolished in favor of the correct conditions for patentability as established by section 103 and applied according to the decisions of this Court, however, the Seventh Circuit's erroneous condition for patentability can be expected to sound the death knell for any design patent which comes before that court in the future, just as it has for all those to which it has heretofore been applied.

A. Conflict with Supreme Court Decisions.

Despite the fact that almost ninety years have passed since this Court has heard a design patent case, a fundamental rule of design patent law established by this Court in the late nineteenth century remains applicable today:

> It is the appearance itself which attracts attention and calls out favor or dislike. It is the appearance itself, therefore, . . . that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense. The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly; but, in whatever way produced, it is the new thing, or product, which the patent law regards.
>
> We do not say that in determining whether two designs are substantially the same, differences in the lines, the configuration, or the modes by which the aspects they exhibit are not to be considered; but we think the controlling consideration is the resultant effect.

Gorham, supra at 524-26. This approach is consistent with, indeed, identical to, that of 35 U. S. C. § 103, calling for examination of "differences between the subject matter sought to be patented and the prior art" in determining whether "the subject matter *as a whole* would have been obvious." The interpretation and application of section 103 in general and of this language in particular was the subject of this Court's opinion in *Graham*.

"Creative Originality in Artistry".

Without adherence to the section 103 "non-obviousness" condition for patentability, numerous and varied formulations of patentability standards might be (and have been, 383 U. S. at 15-17) adopted by the courts. Some of these might give "false readings" of patentability, some might consistently fail to detect patentability, and some might lead to error in either direction depending upon a subjective application by a particular court in a particular situation. After 28 consecutive invalidations of

design patents, there can be little doubt that the Seventh Circuit's "creative originality in artistry" condition for patentability falls squarely in the second category, with the resultant injustice to design patentees for 28 years since the enactment of section 103 in 1952 and 14 years since the *Graham* decision.

The court of appeals dismissed its endorsement of the "creative originality and artistry," "meaningful advance," and "invention" patentability conditions imposed by the trial court as a question of semantics (A 8). The trial court's opinion, however, belies this explanation. As reflected in the excerpt quoted from the district court's opinion above at page 9, it is clear that the trial court interpreted "creative originality in artistry" to require a "revolutionary concept". Whatever the trial court had in mind by "revolutionary concept" in the context of design patents, on its face it goes far beyond a requirement for non-obviousness under the statute.

As this Court stated in *Graham*, "The emphasis on non-obviousness is one of inquiry, not quality. . . ." 383 U. S. at 17. From the excerpts quoted above from *Gorham*, "appearance" and "resultant effect" must be the focus of the inquiry in considering design patents. Applying these principles, the fundamental inquiry must be whether there is a different appearance and resultant effect. The trial court expressly found that there was (A 38), and the court of appeals adopted this finding (A 9 n. 8). Moreover, USM's actions in copying the "Get There" sole instead of prior art available to it evidence the unique appearance of the "Get There" shoe sole. And the overwhelming marketplace reception of the "Get There" shoes after the sound rejection of each of the several prior art soles is still further evidence that the "Get There" shoe sole represented more than an insignificant variation.

Yet, neither court accorded significance to these critical facts, offering instead their wholly subjective and, plaintiff submits, inherently unreliable, *qualitative* judgments. "Revolution-

ary concept," "creative originality," "meaningful advance," and "invention"—those are all *qualitative* judgments based upon the Seventh Circuit's individualized, impossibly high, standard of design patentability.

Non-Obviousness.

Fourteen years after this Court's decision in *Graham* it would be an oblivious court, indeed, that did not at least pay lip service to the approach set out therein for determining non-obviousness under section 103. A brief consideration of the merits will clearly reflect the fact that the "non-obviousness" determinations of both the trial court and the court of appeals were simply warmed-over applications of a "revolutionary concept" standard.

The corollary to the well-established principle that a design patent must be directed to a specific embodiment, *N. Y. Belting Co.* v. *N. J. Rubber Co.*, 137 U. S. 445 (1890), is that the specific embodiment of the design patent and not some generalized concept must be the subject of the section 103 non-obviousness inquiry.[13] Yet the closest the district court came to applying section 103 to the petitioner's design patent was its conclusion that "it would have been obvious to a designer of ordinary skill to design soles with three, four, five or more waves." (A 32, see also A 40, A 45 and A 50).

This "generalized" obviousness conclusion is a blatant misapplication of section 103, as underscored by the later express holding—in the context of the utility patent—that the specific configuration of the "Get There" shoe sole was *non-obvious* (A 45). It is clear that even while purporting to determine the non-obviousness of the design patent under section 103, the district court was in fact applying its "revolutionary" standard

13. As stated by the Court of Customs and Patent Appeals in *In re Marti and Braunschweig*, 359 F. 2d 900, 903 (C. C. P. A. 1966):

> We think the board erred in abstracting a "concept" from appellants' three embodiments, then searching for and applying in a rejection what it considered a common concept which it found in the [prior art] reference.

derived from *Amerock* to what it viewed simply as a "concept" —wavy soles. Indeed, this broad-brush obviousness conclusion has even been urged by USM to have invalidated Famolare design patent, D-235,819, on a three-wave, high-heeled sole design which was not even before the district court in the instant action.[14]

The Seventh Circuit mustered a feeble endorsement of the trial court's approach ("Judge Will was in literal compliance with the *Graham* procedure," A 10). But in struggling to salvage this fundamentally erroneous application of section 103, the court employed a different yet equally misguided approach to section 103 which can be fairly characterized as one of "divide and conquer." It reduced the design to generalized aspects divorced from the *tout ensemble*. It focused on the "wedged shapes, undulating bottoms and raised toes" of the prior art (A 9). Since the generalized characterizations were themselves *drawn* from an overview of the prior art—by the respondents—it is clear that the patent was condemned *ipso facto*.

The court of appeals dismissed the evidence of the "almost meteoric" commercial success and widespread copying of the patented shoe sole in a manner which has become almost boilerplate in the decisions of the Seventh Circuit[15]—"Plaintiff's emphasis upon the commercial success of the 'Get There' shoe cannot rescue the design patent from this finding of obviousness." (A 10) On its face this statement is squarely in conflict with this Court's decision in *Graham*. In *Graham* this Court recognized commercial success as a *direct* consideration, albeit a "secondary" one, in the non-obviousness determination. Yet the Seventh Circuit had already made its determination of

14. *USM Corp.* v. *Famolare, Inc.*, C. A. No. 78 C 2840 (N. D. Ill.), memorandum in support of USM's motion filed April 11, 1979, p. 4.

15. See *e.g., Day-Brite Lighting, Inc.* v. *Sandee Mfg. Co., supra*, at 598, and *Amerock, supra*, at 348. There, as below, the court of appeals suggested that commercial success might be persuasive in "close cases". As explained above, however, its approach to design patentability precludes any such "close cases".

obviousness before even turning to a consideration of whether, in light of the "secondary considerations," that conclusion was wrong.

As this Court recognized in *Gorham*, the basic philosophy behind the granting of design patents is that

> [G]iving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. It therefore proposes to secure for a limited time to the ingenious producer of those appearances the advantages flowing from them.

81 U. S. at 524-26. Thus commercial success has been recognized by this Court to be a fundamental goal of the entire design patent system. Accordingly, its achievement must be given due recognition.

Here the sole was expressly found to be the "most" and the "best" of all a patentable design should be. Yet the courts below ignored the truest of all testing grounds—the marketplace—in favor of a mechanistic approach which stripped the design of its essence, its *tout ensemble*, and reduced the patented design to little more than a combination of individual lines on a piece of paper.

In sharp contrast to the almost indispensable analysis of *mechanisms* in terms of how their individual elements (e.g. wheels, levers, pulleys, etc.) cooperate with one another, reducing a *design* to its "elements" reveals only two, straight and curved lines. Straight lines are obviously old, and curved ones or their equivalents can doubtless be found in the prior art somewhere. Clearly this approach by the Seventh Circuit cannot be the way to evaluate design patents.[16]

16. The current Chief Justice of this Court, while sitting on the D. C. Circuit Court of Appeals, recognized that by their nature designs are not susceptible to the same type of analysis which might be argued relative to utility patents, "[I]f we properly understand the Commissioner's position on the *Graham* case, he is using the advancement standard in such a manner that design patents would be invalid . . ." *Commissioner of Patents* v. *Deutsche Gold-Und-Silber-Schneideanstalt*, 397 F. 2d 656, 667 n. 31 (D. C. Cir. 1968).

B. Importance of the Question.

This Court's decision in *Graham* was truly a landmark decision. Properly applied in conjunction with *Gorham*, the principles in *Graham* are wholly applicable to *design* patents, notwithstanding the fact that *Graham* involved a *utility* patent. The Seventh Circuit, however, is nullifying the design patent system by, in effect, legislating it out of existence with its own non-statutory patentability conditions. The passage of almost 90 years since this court last spoke directly on design patents makes this a proper time to speak once again.

C. Conflict Between Courts of Appeal.

As the petitioner has discussed above, the Seventh Circuit's approach to section 103 is contrary to the statute itself, especially taken with this Court's opinions in *Gorham* and *Graham*. The Seventh Circuit's decision below also squarely conflicts with decisions of five other circuits since section 103 was enacted.

The Third Circuit in *R. M. Palmer Co.* v. *Ludens, Inc.*, 236 F. 2d 496 (3d Cir. 1956), reviewed the impact of the Patent Act of 1952 on the state of law of patents generally and the law of design patents specifically. The court then quoted from *Gorham*, as above, and held:

> It is almost unavoidable that the visual sense is the primary testing ground, and that the design must be looked at as a whole . . . [W]hile arms, legs, and other various parts of the body and ornamentations are necessary parts of the [patented exaggerated caricatures], it is the whole upon which the decision must be based.

236 F. 2d at 501. As to "the special importance of commercial success in determining the validity of a design patent," the Third Circuit cited the earlier Fourth Circuit decision of *Glen Raven Knitting Mills, Inc.* v. *Sanson Hosiery Mill, Inc.*, 189 F. 2d 845 (4th Cir. 1951). There, in upholding a design patent on a highly successful heel design for women's stockings, the Fourth Circuit stated:

> It is . . . obvious that in dealing with patents of this kind much weight must be given to commercial success, and all the more so when wearing apparel, which must please the buyer, is the subject to which the design applies. The immediate success of the [stocking embodying the patented design] its command of a higher price, its refined simplicity and ease of manufacture, its acceptance by competitors, and its reception and acclaim by the world-wide public all attest to something more than commonplace ornamentation or uninspired reassembly of old ideas.

189 F. 2d at 853. Similarly, the Fifth Circuit in *Sel-O-Rak Corp.* v. *Henry Hanger & Display Fix. Corp.*, 232 F. 2d 176 (5th Cir. 1956), and the Ninth Circuit in *Robert W. Brown & Co.* v. *DeBell*, 243 F. 2d 200 (9th Cir. 1957), both citing *Gorham* and *Glen Raven*, recognized copying and commercial success as significant factors evidencing the patentability of designs.

Moreover, in reaching a non-obviousness determination expressly under section 103 as applied in *Graham*, both the Sixth Circuit, in *Schnadig Corp.* v. *Gaines Mfg. Co.*, 494 F. 2d 383 (6th Cir. 1974), and the Second Circuit, in *Lancaster Colony Corp.* v. *Alden Accessories, Ltd.*, — F. Supp. —, 184 USPQ 193 (2d Cir. 1974), recognized copying and commercial success as important indicia of design patentability. Further, both circuits recognized that designs must be considered *as a whole*. 494 F. 2d at 390, 184 USPQ at 194-95. *See also* the Second Circuit's earlier decision in *International Silver Co.* v. *Pomerantz*, 271 F. 2d 69 (2d Cir. 1959).

Clearly, the approach taken to the design patent validity by the Seventh Circuit is in direct conflict with that of six other courts of appeals. This Court's guidance on the consideration of the *tout ensemble* and of copying and commercial success is essential to resolve the conflict and to reassure designers that the incentives and rewards of the patent system are not illusory.

CONCLUSION.

For the reasons stated above, this Petition for Certiorari should be granted.

Respectfully submitted,

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April 1980

APPENDIX

APPENDIX

Unpublished Per Curiam Order

UNITED STATES COURT OF APPEALS

For the Seventh Circuit

Chicago, Illinois 60604

January 30, 1980

Before

Hon. Thomas E. Fairchild, *Chief Judge*
Hon. Walter J. Cummings, *Circuit Judge*
Hon. Philip W. Tone, *Circuit Judge*

Famolare, Inc.,
Plaintiff-Appellant,

No. 79-1451 *vs.*

Edison Brothers Stores, Inc. and USM Corporation,
Defendants-Appellees.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

No. 75-C-2708

Hubert L. Will,
Judge

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Illinois, Eastern Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, AFFIRMED, with costs, in accordance with the order of this court entered this date.

Unpublished Order Not To Be Cited Per Circuit Rule 35

UNITED STATES COURT OF APPEALS
For the Seventh Circuit
Chicago, Illinois 60604

Argued November 2, 1979

January 30, 1980

Before

Hon. Thomas E. Fairchild, *Chief Judge*
Hon. Walter J. Cummings, *Circuit Judge*
Hon. Philip W. Tone, *Circuit Judge*

Famolare, Inc.,
Plaintiff-Appellant,

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No. 75-C-2708

Hubert L. Will,
Judge

ORDER

This suit originated with a three-count complaint charging Edison Brothers Stores, Inc. with infringing plaintiff's Design Patent No. D235,701 (issued July 8, 1975), infringing plaintiff's trademark, and engaging in unfair competition. Shortly after the suit was commenced, USM Corporation intervened as a defendant. Plaintiff subsequently charged both defendants with infringement of plaintiff's Utility Patent No. 3,937,956,

which issued on February 10, 1976,[1] approximately six months after the original complaint was filed. After extensive discovery and a bench trial, the district court entered findings of fact and conclusions of law and in a memorandum opinion held both patents invalid. It also granted plaintiff's motion to dismiss with prejudice its Count II claims of trademark infringement and unfair competition.[2] This appeal ensued. We affirm.

Background

The subject matter of the patents at issue here is a wavy-bottomed shoe sole. The original patentee, Joseph P. Famolare, Jr. is a veteran shoe designer and the founder of plaintiff, Famolare, Inc., which manufactures and markets shoes employing the wavy-bottomed soles from its principal place of business in New York City. Defendant Edison, which has its principal place of business in St. Louis, Missouri, owns and operates retail shoe stores in various parts of the United States. Since 1975 it has purchased for resale shoes with the accused soles from defendant USM, which manufactures the soles in New Jersey for sale to various manufacturers around the country.

Joseph Famolare first conceived and sketched a design for the wavy-bottomed shoe sole in question in the fall of 1973. To develop the concept, he immediately had three wooden sole models prepared, one of which contained four waves, and he eventually had several women's shoes manufactured with a sole containing a four-wave design. Mr. Famolare first offered these shoes for sale at the March 1974 Chicago Shoe Show in

1. Plaintiff originally introduced the utility patent infringement claim into this lawsuit on February 24, 1976, by a proposed "Claim Against Intervenor [USM] and as a Class Action." The district court denied this proposal on April 20, 1976. Plaintiff evidently renewed the utility patent claim in its April 26, 1976, replies to the amended and supplemental counterclaims. The replies are not contained in the record on appeal.

2. Plaintiff early admitted that it intended not to pursue Count III, an additional unfair competition count contained in the complaint. The district court dismissed this count with prejudice on motion of defendants on June 28, 1976.

McCormick Place, later making them available to retailers in September 1974 under the trade name of the "Get There" shoe. The shoes proved to be a great success. Thus from fiscal 1975 through fiscal 1977, the wavy-soled shoes accounted for half of plaintiff's business, boosting its total sales from $20 million to $40 million. In fiscal 1978, plaintiff sold $30 million worth of "Get There" shoes out of a total of $70 million in sales,

Even before the shoes were made generally available to retailers and the four-wave design enjoyed a commercial success, Mr. Famolare applied first for a design patent and then for a utility patent to cover wavy soles. In prosecuting the design patent he made available to the Patent Office two items of prior art: U.S. Design Patent No. 136,969, which was issued to Berkowitz in 1944 and covered a one-piece sole having five undulations in the forepart of the sole; and French Patent No. 830,150 which was issued in 1938 and covered a conventional sole with a series of parallel lines along its side. Design Patent '701 was subsequently issued to Mr. Famolare in July 1975 and he assigned it to plaintiff. The patent covers "[t]he ornamental design for a shoe sole, substantially as shown and described" in six included figures (App. 58). That sole has a bottom contour with four undulations and, on the side of the shoe, a series of spaced parallel lines that follow the shape of the undulated bottom contour.

The utility patent issued in February 1976. The drawings included in that patent illustrate a shoe sole substantially similar to the sole shown in the design patent. Claim 1 of the utility patent specifies that the sole is to consist of a thick body of resilient, shock absorbing sole material and then describes an undulated bottom shoe sole in broad terms.[3] The specifications of the utility patent include the statement that its sole makes it

3. Claim 1 provides:

"A reflex action one-piece sole for shoes, which comprises:

"a. a longitudinally extending thick body of resilient, shnock [sic] absorbing material;

(Footnote continued on next page.)

easier to walk "by adding to or supplementing normal walking movements" because of the shape and configuration of the sole bottom with its compound curved bottom surfaces, curved configuration, and alternating patterns of crests and troughs (App. 61).

While the patents were still pending, the success of the "Get There" shoe encouraged imitations. After vainly endeavoring to obtain a license from plaintiff in April and May 1975, defendant USM began manufacturing and selling its accused soles

(Footnote continued from preceding page.)

"b said body including generally horizontal upper surfaces, an edge wall having front, side, and rear portions, and a bottom surface;

"c. said bottom surface comprised of alternating crests and troughs extending completely thereacross and being generally perpendicular to the longitudinal axis of said body;

"d. said crests including spaced, lowermost ground contacting portions;

"e. said alternating crests constituting in succession, a forwardmost toe crest, an intermediate ball crest, an intermediate shank portion crest, and a heel crest, the lowermost ground contacting surfaces of the latter three crests lying in a substantially common plane;

"f. said forwardmost toe crest being elevated with respect to the remainder of said crests and extending forwardly toward and terminating at front edge portions of said sole to provide a rolling, thrusting action as the sole is progressively engaged with a ground surface in walking; and

"g. said heel crest extending upwardly and rearwardly toward and terminating in said rear edge portions of said sole to provide an initial rolling action as the sole is progressively engaged with a ground surface in walking;

"h. said sole thereby providing a gentle rocking motion as it progressively contacts a ground surface." (App. 62-63.)

Plaintiff also relies on Claim 7, which provides:

"A reflex action one-piece sole for shoes, which comprises

"a. a longitudinally extending thick body of resilient, shock absorbing material;

(Footnote continued on next page.)

without a license. Defendant Edison and others began purchasing the USM shoes with the accused soles almost immediately. Throughout this period, plaintiff was notifying the industry of its claim of proprietary right in the four-wave design as well as in the three-wave and five-wave soles. Some manufacturers and sellers thereafter discontinued certain shoes and soles or sought indemnity from defendant USM.

In August 1975 plaintiff filed this suit charging Edison with a violation of its design patent, which had issued in July. USM intervened and after the Patent Office issued the utility patent

(Footnote continued from preceding page.)

"b. said body including an upper foot supporting surface, an edge wall having front, side, and rear portions, and a bottom surface;

"c. said bottom surface comprised of alternating crests and troughs extending completely thereacross and being generally perpendicular to the longitudinal axis of said body;

"d. said crests including spaced, lowermost ground contacting portions;

"e. said alternating crests constituting in succession, a forwardmost toe crest, an intermediate ball crest, an intermediate shank portion crest, and a heel crest." (App. 63.)

Originally, plaintiff also relied on Claim 14, which provides for three or more waves (App. 63), but it withdrew that claim at trial (Tr. 607). Claim 14 provides:

"A reflex action one-piece sole for shoes, which comprises

"a. a longitudinally extending thick body of resilient, shock absorbing material;

"b. said body including an upper foot supporting surface, an edge wall having front, side, and rear portions, and a bottom surface;

"c. a plurality of shallow shaped crests having predetermined circumferential lengths and predetermined depths, said circumferential lengths being a multiple of not less than six times said predetermined depths for each of said shallow shaped crests;

"d. said crests including spaced, lowermost ground contacting portions, and

"e. said alternating crests constituting in succession, a forwardmost toe crest, at least one intermediate crest, and a heel crest." (App. 63.)

in February 1976, plaintiff added to its complaint allegations that both defendants infringed that patent.[4] Relying on sixteen prior art publications and seven prior art shoes and soles, defendants counterclaimed for a declaratory judgment for noninfringement, invalidity, misuse, and unenforceability of the patents. After a bench trial, Judge Will held the design patent invalid on the ground that "it lacks invention over the prior art and reflects no creative originality or artistry"[5] and also because the alleged improvement over the prior art was obvious under 35 U. S. C. § 103. Although he found the utility patent not obvious, Judge Will nevertheless held that patent invalid both because "it represents no significant advance in shoe sole design and, therefore, involves no invention" and because it is indefinite under 35 U. S. C. § 112. Plaintiff's appeal followed.

The Design Patent Was Invalid for Lack of Invention and Obviousness.

In the opinion accompanying his finding that the design patent was invalid, Judge Will noted that the sketches embodying the patented design were of a four-wave sole with very slight crests and hollows. He thus held that plaintiff's design patent did not reach to three-wave and five-wave soles, a conclusion plaintiff does not contest. Then, upon applying the

4. In Count II of the complaint, plaintiff also charged Edison with trademark infringement and unfair competition in violation of 15 U. S. C. § 1125, Ill. Rev. Stats. ch. 140, §§ 22-28 and ch. 121½, §§ 311-317, and the trademark common law of Illinois. USM was not charged with any acts of unfair competition or trademark infringement. Plaintiff ultimately moved to dismiss with prejudice its trademark and unfair competition claims against Edison, a motion the district court granted in the process of deciding the infringement and validity issue.

5. The phrase apparently should be "creative originality in artistry" and so appears in Judge Will's accompanying opinion (App. 38) and in *Amerock Corp.* v. *Aubrey Hardware Manufacturing, Inc.*, 275 F. 2d 346, 348, 349 (7th Cir. 1960), which Judge Will cites. Judge Lindley first used the phrase in *Battery Patents Corp.* v. *Chicago Cycle Supply Co.*, 111 F. 2d 861, 862 (7th Cir. 1940), cited by Judge Hastings in *Amerock*.

statutory language requiring the design to be "new, original, ornamental and nonobvious" (App. 34; see 35 U. S. C. §§ 171 and 103), Judge Will found the patent invalid for two reasons. First, he concluded that the claimed improvement lacked invention on the ground that "it does not represent such an inventive contribution to the public or such a meaningful advance in the shoe design art that it constitutes invention." Second, he found the alleged improvement obvious under 35 U. S. C. § 103 because the variations or modifications between the prior art and plaintiff's wave soles "are not so substantial that they would be beyond the skill of ordinary designers working in the shoe design art" (App. 40, 41).

Plaintiff resists these conclusions on both theoretical and practical grounds. Concerning the question of invention, it emphasizes that the district court considered not only whether the design represents an "inventive contribution" and "a meaningful advance," but also whether the patent represented "creative originality in artistry."[6] This latter standard is improper, it argues, because it is equivalent to the "flash of creative genius" standard enunciated in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 91, and later overturned by Congress in 35 U. S. C. § 103. A mere reading of the two phrases, however, belies plaintiff's contention. The case law also demonstrates that the language Judge Will employed has long been a hallmark for considering the question of invention in this Circuit. *Amerock Corp.* v. *Aubrey Hardware Manufacturing, Inc.*, 275 F. 2d 346, 348-349 (7th Cir. 1960); *Vollrath Co.* v. *Premium Plastics, Inc.*, 385 F. Supp. 843, 851 (N. D. Ill. 1974) (Bauer, J.); *R-Way Furniture Co.* v. *Duo-Bed Corp.*, 216 F. Supp. 862, 866 (N. D. Ill. 1962); see also *Frantz Manufacturing Co.* v. *Phenix Manufacturing Co.*, 457 F. 2d 314, 327 (7th Cir. 1972) (Stevens, J.) ("creative artistic activity"). There is, meanwhile, no question that the issue of invention, properly understood (as it was below), remains relevant to the

6. See note 5 *supra*.

consideration of patent validity. *Republic Industries, Inc.* v. *Schlage Lock Co.*, 592 F. 2d 963, 968 and n. 13 (7th Cir. 1979).

Second, plaintiff asserts that Judge Will permitted this language of invention to supplant completely the statutory test of obviousness and prevented him from comparing the prior art with the overall effect created by the Famolare four-wave sole. In particular, plaintiff notes that Judge Will found several prior-art soles, including especially the Canadian Super Stroller, to be relevant to consideration of the Famolare sole,[7] despite significant differences between the products. It is clear from the district court opinion, however, that Judge Will neither employed the invention language to the exclusion of the particularized inquiry into obviousness mandated by 35 U. S. C. § 103 and *Graham* v. *John Deere Co.*, 383 U. S. 1, 17, nor ignored the overall effect created by the Famolare sole. The wedged shapes, undulating bottoms and raised toes present in the Super Stroller shoe and the other soles give them an appearance plainly relevant to a consideration of the prior art. After acknowledging the differences between this prior art and the Famolare sole,[8]

7. The Canadian Super Stroller shoe was designed in March 1973, displayed thereafter in New York, and offered for sale in late August or early September of that year. It contains a four-wave sole, although with crests and hollows that are somewhat different from those in plaintiff's sole. Like the Famolare sole, it has a rounded heel.

The district court mentioned five other wavy soles designed before Mr. Famolare created the sole at issue here. The Benetti sole, which was designed as early as April 1971, sold in the United States that same year and offered to plaintiff for sale in 1972, has five waves, but, except for the fifth wave, it resembles the sole depicted in plaintiff's design patent. The USM Ran sole, also with five waves, and the Mitsubishi sole, with seven waves, first appeared in 1971. The three-wave Zeni Onda sole was designed in the early 1970's, and first appeared in the United States in January 1973. Finally, the five-wave Hlustik sole, which resembles the Benetti and USM Ran soles, first appeared in the United States in 1971. None of these soles was a commercial success.

8. Judge Will actually said that "the effect or appearance of the Famolare four-wave sole is different than any of the prior art with

(Footnote continued on next page.)

Judge Will noted that the skill in the art was well developed, since, as demonstrated by the variety of wavy-soled shoes predating the Famolare design, all shoe designers were experimenting broadly with the wavy-soled design during the early 1970's. Having determined these facts, Judge Will was in literal compliance with the *Graham* procedure. Upon this record, he was clearly justified in finding that the subject matter of the patent was obvious.

Plaintiff's emphasis upon the commercial success of the "Get There" shoe cannot rescue the design patent from this finding of obviousness. Commercial success is a secondary consideration, most often useful for deciding close cases. Its usefulness is attenuated, however, where, as here, so many external factors may have contributed to the shoe's success. As Judge Will noted, fads often predominate in the fashion shoe market and timing can be extremely important. Features totally unrelated to the design of a shoe can play a major role in its success. It is thus worth noting that shoes with plaintiff's three-wave and five-wave soles also achieved greater success during this period than similar soles had experienced previously,[9] thereby indicating that the acceptance won by the sole at issue here was not

(Footnote continued from preceding page.)
the Canadian Super Stroller being most similar" (App. 37). This statement alone refutes plaintiff's contention that the district court failed to compare the total effect of the Famolare sole with the prior art. This kind of determination is perfectly consistent with the customary test for obviousness, which depends not on a finding that the claimed invention is identical to what has preceded it but rather on a consideration whether a person having ordinary skill in the art would find the claimed improvement obvious given its differences from the prior art. 35 U. S. C. § 103; *Graham* v. *John Deere Co.*, 383 U. S. 1, 17. It is worth noting, moreover, that plaintiff's own presentation of the attributes of the "Get There" and Super Stroller shoes overstates the differences between the two by depicting the "Get There" shoe at a slight angle, thereby accentuating its wavy contour, while presenting the Super Stroller shoe flat against the ground, a position that minimizes its wavy appearance (App. 73).

9. Their success was admittedly not as great as that achieved by the four-wave design.

necessarily inherent in its four-wave design. The success of the "Get There" shoe is simply too weak a reed upon which to rest a claim of invention or non-obviousness for the Famolare four-wave sole. Since, moveover, we find Judge Will's holding on this issue to be correct, it is not necessary to consider defendants' other arguments for invalidating the design patent.

The Utility Patent Was Invalid for Indefiniteness.

In pressing its allegations of infringement of the utility patent, plaintiff relied solely on Claims 1 and 7 of that patent. See note 3 *supra.* After reviewing these claims, Judge Will found the four-wave sole, with the alleged comfort advantages of four crests placed under the four weight-bearing points of the foot, to be non-obvious under 35 U. S. C. § 103 although there was evidence that the weight-bearing parts of the foot are widely known[10] and that other soles, including the 1971 Benetti sole with five crests, achieved comparable results in wearing comfort. But Judge Will held the patent invalid anyway both because "it does not represent a significant advance in shoe sole design,"[11] and because it was not sufficiently definite to meet the requirements of 35 U. S. C. § 112.

10. Judge Will noted that "[a]ll experts on both sides agreed that there are four normal weight bearing locations of the foot and that this has been well known for many years" (App. 45). However, he apparently concluded that the level of skill among shoe designers did not include an appreciation of the importance of these weight-bearing points (App. 48).

11. Noting the paradox inherent in finding the design patent obvious while finding the utility patent non-obvious, Judge Will stated that "while designing shoe soles with three, four, five or more waves and crests would be obvious to an ordinarily skilled designer, the placement of each of four crests at the four weight bearing points of the foot apparently was not obvious * * *" (App. 48-49). Judge Will was not so forthcoming in explaining how the utility patent could be both nonobvious and lacking in invention. Evidently he relied on the existence of other soles that, although different from the Famorale sole in appearance, provide similar comfort by comparably supporting the four weight-bearing parts of the foot. The existence of such soles might well deprive the Famolare sole

(Footnote continued on next page.)

On the question of indefiniteness, the district court found that no one reading the "ambiguous" claims of the patent could determine the scope of Mr. Famolare's claimed invention. As Judge Will noted, far from clearly describing a four-wave sole, the patent stat s in its specifications that:

> "[t]his invention is not limited to that particular arrangement, and, as will be appreciated and understood by those skilled in the art, changes may be made therein without departing from the scope of the invention which is defined in the appended claims. For example, the specific geometry of the sole may be modified or somewhat altered (in terms of proportions, number of crests and troughs, etc.) while maintaining the beneficial properties and characteristics of the illustrated sole by stretching the back of the leg and providing a distinct and positive forward thrust to the wearer in a general, 'free and flowing,' mutiple waved manner." (App. 52)

More particularly, he noted that plaintiff had itself conceded that the claims are ambiguous in the following respects:

> "1) They fail to specify the precise number of crests and troughs on the sole bottom.
>
> "2) They fail to define the precise location of the crests in that the 'shank' region of a shoe covers two points and the ball of the foot is diagonal running from the base of the large toe to the base of the little toe, while the claims call or crests running at right angles to the longitudinal axis of the sole.
>
> "3) They fail to specify the shape or dimensions of the waves in that they fail to specify the heights or base widths of the various crests or the depths of the troughs.
>
> "4) They fail to define the range of resilience or shock absorption of the material to be used as well as the

(Footnote continued from preceding page.)
of novelty and therefore disqualify it as an invention under 35 U. S. C. § 101. See *Republic Industries, Inc.* v. *Schlage Lock Co.*, 592 F. 2d 963, 968 n. 13 (7th Cir. 1979). Because of our holding on the indefiniteness issue, we express no opinion on the non-invention holding.

> relationship between the thickness and the degree of resilience or flexibility.
>
> "5) They fail to specify the degree of toe elevation.
>
> "6) They claim 'a reflex action' without specifying how that can be achieved since neither the claims nor the specifications identify the four normal weight bearing points of the foot or the correlation of the crests therewith." (App. 50-51.)

Thus according to Judge Will, "the claims are not specific enough to define the invention so that a knowledgeable person could either build a sole embodying the invention or know its bounds in order to design around it" (App. 52-53).

We believe Judge Will's reasoning on the indefiniteness issue has a sound basis in law and in fact. The pertinent part of 35 U. S. C. § 112 requires that a patent shall "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as invention." As the Supreme Court has held, the patent must contain "a distinct and specific statement of what [the applicant] claims to be new and to be his invention" and must "inform the public * * * of the limits of the monopoly asserted." *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U. S. 364, 369. Despite these requirements, the utility patent failed in all the particulars noted by the district court. Indeed, the claims as a whole proved to be so indefinite that even plaintiff's expert, Dr. Brachman, could not determine the bounds of the invention from them.[12]

Plaintiff responds by asserting that Claims 1 and 7 necessarily cover only the Famolare four-wave sole since those claims refer to crests beneath the heel, shank, ball and toe of the foot. It is critical, however, that these claims lack the minimum specifics necessary to convert this general description into terms pinpointing the four-wave sole as the subject matter of the inven-

12. Plaintiff's response that Dr. Brachman could find a four-wave sole within the claims of the patent is wholly irrelevant for determining whether the patent has clear limits.

tion. For example, the claims nowhere discuss these general areas of the foot in terms of their weight-bearing characteristics nor do they describe the structure of the crests in orthopedic or anatomical terms. It is, moreover, axiomatic that claims must be read in light of their specifications. *United States* v. *Adams*, 383 U. S. 39, 49; 4 Deller's Walker on Patents (2d ed.) § 246. As shown by the passage we have quoted from the district court's opinion, the specifications only reinforce the notion that the claims are not limited to the four-wave design. We agree with the district court that this lack of specificity stems from Mr. Famolare's primary interest in design rather than utility and a desire to protect all his wavy soles rather than a particular four-wave configuration. The result is a set of claims too vague to enjoy protection as a useful invention.

IN THE UNITED STATES DISTRICT COURT
For the Northern District of Illinois
Eastern Division

Famolare, Inc.,
Plaintiff,
vs.
Edison Brothers Stores, Inc. and USM Corporation,
Defendants.
No. 75 C 2708

FINDINGS OF FACT CONCLUSIONS OF LAW AND MEMORANDUM OPINION.

The Court, having heard the evidence and having considered the pleadings and the final pretrial order as well as the briefs and arguments of counsel, makes the following findings of fact, conclusions of law, and enters the following opinion.

Findings of Fact

1. The Parties

1.1 Plaintiff, Famolare, Inc. (Famolare), is a corporation organized and existing under the laws of the State of Delaware and having its principal place of business within the State of New York at 4 West 58th Street, New York, New York 10010.

1.2 Defendant, Edison Brothers Stores, Inc. (Edison), is a corporation organized and existing under the laws of the State of Delaware and having its principal place of business at 400 Washington Avenue, St. Louis, Missouri 63178: Edison or its subsidiaries (who are not named parties in this action) owns or operates retail shoe stores in this district, and elsewhere. Retail shoe stores owned or operated by Edison or its (non-named party) subsidiaries include Chandlers, Bakers, Leeds, Burts

and The Wild Pair. The accused shoes have been sold through one or more of the foregoing stores.

1.3 Defendant, USM Corporation (USM), is a corporation organized and existing under the laws of the State of New Jersey which through its Premolded Sole division sells shoe soles to various shoe manufacturers. USM intervened as a party defendant pursuant to the Order of this Court dated September 18, 1975.

2. The Pleadings and Venue

2.1 In view of the extensive pleadings in the present action, the parties agree that the following pleadings define the issues to be resolved:

Title of Pleading	Date Filed
1. Complaint	8/13/75
2. Answer & Counterclaims (Note: Counterclaim portion of the pleading has been superseded by pleading 4 below)	9/18/75
3. Intervener's Answer and Counterclaims (Note: Counterclaim portion of this pleading has been superseded by pleading 5 below)	9/18/75
4. Amended and Supplemental Counterclaims of Edison	4/5/76
5. Amended and Supplemental Counterclaims of USM	4/5/76
6. Reply to Amended and Supplemental Counterclaims of Edison and Counterclaim Against Edison	4/26/76
7. Reply to Amended and Supplemental Counterclaims of USM and Counterclaims Against USM	4/26/76
8. Reply of Intervenor USM to Plaintiff's claims and Certain Affirmative Defenses	5/18/76
9. Reply of Defendant Edison to Plaintiff's Counterclaim	5/18/76

2.2 This is an action by plaintiff Famolare:

I. For infringement of U. S. Patent No. 3,936,956 and U. S. Patent D-235,701 (patents in suit) in respect to Edison and USM which arises under the Patent Act of 1952, 35 U. S. C. § 1, *et seq.*,

II. For violation of the trademark and unfair competition laws of the United States with respect to defendant Edison which arises under the trademark laws of the United States, 15 U. S. C. § 1125(a),

III. For violation of the trademark and unfair competition laws of the State of Illinois in respect to defendant Edison arising under the common law and statutes of the State of Illinois, more particularly, S. H. A. Ill. Chapter 140, §§ 22-28 and Chapter 121½ §§ 311-317.

2.3 Each of the defendants, Edison and USM, has filed counterclaims against plaintiff:

I. For a declaratory judgment of non-infringement, invalidity, misuse and unenforceability of the patents in suit pursuant to 28 U. S. C. §§ 2201-02,

II. For unfair competition under the statutes and common law of Illinois and the United States.

2.4 Plaintiff waived its jury demand, and for the purpose of this litigation the affirmative defenses pled in paragraphs 57, 58 and 59 of Famolare's Reply to Amended and Supplemental Counterclaim of USM (April 26, 1976), and paragraphs 59(a) and (b) of Famolare's Amended Reply to Amended and Supplemental Counterclaims of USM (December 10, 1976).

2.5 Jurisdiction is founded under 28 U. S. C. § 1338(a) and (b).

2.6 Venue is based upon 28 U. S. C. § 1391(b) and (c) and § 1400.

2.7 Venue and jurisdiction are not contested by any party to this suit in respect to the claims or counterclaims in issue.

3. Patents in Suit

(a) United States Patent No. 3,936,956 ("Utility Patent," copy attached as Appendix B)

3.1 The Famolare utility patent in suit, U. S. Patent No. 3,936,956, issued February 10, 1976 to Joseph P. Famolare, Jr., assignor to Famolare, Inc., entitled "Reflex Action Sole for Shoes Having Sinuous Contoured Bottom Surface."

3.2 The Famolare utility patent in suit is owned by plaintiff, Famolare, Inc.

3.3 The Famolare utility patent in suit issued on the basis of application Serial No. 499,493 filed August 22, 1974.

(b) United States Design Patent No. Des. 235,701 ("Design Patent," copy attached as Appendix A)

3.4 The U. S. Design Patent No. 235,701 issued July 8, 1975 to Joseph P. Famolare, Jr., assignor to Famolare, Inc., and is entitled "Shoe Sole."

3.5 The design patent in suit is owned by the palintiff, Famolare, Inc.

3.6 The design patent in suit issued on the basis of application Serial No. 473,336, filed May 28, 1974.

3.7 The Famolare design patent in suit has a single claim to "the ornamental design for a shoe sole, substantially as shown and described." The shoe sole which is shown in the design patent has a bottom contour with four undulations and a series of spaced parallel lines on the side of the sole that follow the shape of its undulated bottom contour.

3.8 Notice that prosecution on the merits was closed was mailed on February 19, 1975; the formal notice of allowance was mailed on April 15, 1975; the issue fee was paid on April 22, 1975 and the design patent issued on July 8, 1975.

3.9 The file history shows that only two items of prior art were found and considered by the Patent Office during prosecution of the design patent in suit—United States Design Patent No. 136,969 to Berkowitz, which was issued in 1944 and illustrated a one-piece sole having five undulations in the forepart of the sole, and French Patent No. 830,150, which was issued in 1938 and showed a conventional sole with a series of parallel lines along the side of the sole.

3.10 The drawings of Famolare's utility patent illustrate the same shoe sole that is shown in its design patent, namely, a single piece shoe sole with a bottom contour having four undulations. The specification of the utility patent states that the undulated bottom sole that is shown and described in the patent makes it easier to walk "by adding to or supplementing normal walking movements" (Col. 1, lines 15-16), in substantial part because of the shape and configuration of the sole bottom itself:

> "Moreover, the sole of this invention, because of the *compound curved bottom surfaces* thereof, provides a rocking and thrusting action even during standing, which rocking action serves to enhance and tone the leg muscles of the wearer. This results in an exhilarating, determined stride, which reduces fatigue and ultimately enhances the desire and ability to walk, and gives the wearer a feeling of well-being." (Col. 1, lines 49-57)
>
> * * * * *
>
> "Moreover, the construction of the sole herein, with its *curved configuration,* incorporates a continuous impulse-type reflexive action which increases the muscle tone of the wearer, whether or not he is walking or merely standing still." (Col. 4, lines 12-16)
>
> * * * * *
>
> "This *alternating pattern of crests and troughs* serves to incorporate into sole 12 and inherent roll-generating action, which provides for the wearer a positive enhanced reflex action during his striding movements." (Col. 3, lines 23-27)

3.11 The Famolare utility patent was issued with 19 claims, not all of which are at issue in this action. Claim 1 of the utility

patent (which is one of the three independent claims) specifies the use of "resilient, shock absorbing" sole material, and provides a broad verbal description of an undulated bottom shoe sole:

> "1. A reflect action one-piece sole for shoes, which comprises
>
> a. longitudinally extending thick body of resilient, shnock [sic] absorbing material;
>
> b. said body including generally horizontal upper surfaces, an edge wall having front, side, and rear portions, and a bottom surface;
>
> c. said bottom surface comprise of alternating crests and troughs extending completely there-across and being generally perpendicular to the longitudinal axis of said body;
>
> d. said crests including spaced, lowermost ground contacting portions;
>
> e. said alternating crests constituting in succession, a forwardmost toe crest, an intermediate ball crest, an intermediate shank portion crest, and a heel crest, the lowermost ground contacting surfaces of the latter three crests lying in a substantially common plane;
>
> f. said forwardmost toe crest being elevated with respect to the remainder of said crests and extending forwardly toward and terminating at front edge portions of said sole to provide a rolling, thrusting action as the sole is progressively engaged with a ground surface in walking; and
>
> g. said heel crest extending upwardly and rearwardly toward and terminating in said rear edge portions of said sole to provide an initial rolling action as the sole is progessively engaged with a ground surface in walking;
>
> h. said sole thereby providing a gentle rocking motion as it progessively contacts a ground surface."

4. The Background of the Patentee and the patented Soles

4.1 Mr. Joseph P. Famolare, Jr., the named patentee of both the design and utility patents in suit (Mr. Famolare), has been

a shoe designer for many years. He founded Famolare, Inc. (Famolare) in 1969 and has been its principal designer since its inception.

4.2 In the fall of 1973 while on board an American air carrier enroute to London, England from New York, New York, Mr. Famolare conceived and sketched a design for a wavy-bottom shoe sole. Upon reaching his Florence, Italy office, after arriving in Italy from London, he discussed the design with his assistants, Messrs. Franco Bashieri and Roberto Niccoli. During the course of the meeting with his assistants, or immediately thereafter, a date was made with Formificio Romognolo S.p.A. (Formifico), a last factory located in Forli, Italy.

4.3 Mr. Famolare and his assistants drove to Forli and met with Mr. Franz Mersecche, a model maker for Formificio. With Mr. Mersecche's assistance, several wooden models of soles with wavy bottoms were prepared from Mr. Famolare's sketches. These included a three wave, four wave and a five wave model.

4.4 These wooden models were then brought back to Mr. Famolare's office in Florence, Italy for study following which Mr. Bondi of Expansion s.n.c. (Expansion), a sole manufacturer, was contacted concerning the preparation of a die or mold. Mr. Bondi and Mr. Famolare met at Formificio's Forli, Italy factory and discussed the four wave, wooden model Mr. Famolare had selected for further development. Mr. Bondi suggested some minor modifications to permit the sole to be removed from the mold. Mr. Famolare specified that the soles would be constructed from a well known synthetic rubber material, sold under the tradename "Kraton," and decided as well that his soles would be manufactured by equally well known injection molding techniques commonly in use for the manufacture of molded one piece unit soles.

4.5 Mr. Bondi was given the four wave wooden model of the sole (first wooden model) and requested to prepare a mold or die. Mr. Bondi placed an order for a mold to be made from

the first wooden model with Lorenzin S.p.A., a mold manufacturer (Lorenzin).

4.6 Lorenzin received the first wooden model in October 1973 and confirmed the order on October 20, 1973 (PTX-402). Pursuant to Mr. Bondi's order, Lorenzin prepared a simple mold (PTX-398 and PTX-399).

4.7 After receiving the first mold (PTX 398 and PTX 399), Mr. Bondi prepared the first renderings of the four wave sole in a flexible material (PTX-400 and PTX-401) and presented them to Mr. Famolare. Mr. Famolare and Mr. Bondi discussed these renderings following which Mr. Bondi was authorized to prepare a single production mold.

4.8 Mr. Bondi placed an order with Lorenzin in February of 1974 for a single production mold without any tread design. Lorenzin confirmed the order on February 21, 1974 (PTX-403). After receiving the single production mold from Lorenzin, Mr. Bondi made soles from that mold and, at Mr. Famolare's direction, delivered those soles to Sogis, a manufacturer of Famolare shoes. Sogis, in turn, made prototype shoes (PTX-557) using the soles it received from Mr. Bondi and a "Get There" last received from Formificio (PTX-558).

4.9 Mr. Famolare brought several sample women's shoes with soles having the four wave design to the March 1974 Chicago Shoe Show at McCormick Place where they were exhibited to the trade and first offered for sale.

4.10 The soles of the shoe shown at the March 1974 Chicago Shoe Show had the same general appearance as the patented design and the same general construction as specified in the Utility Patent in suit.

5. Sales of Shoes by Famolare

5.1 The four wave sole shoes, given the trade name "Get There," were first delivered to Famolare's customers in August 1974. They went on sale to the public through retailers in September 1974.

5.2 Famolare sells its shoes to about 1,500 retailers. Representative stores handling Famolare shoes are Marshall Field, Chicago; Bergdorf Goodman, New York; Jordan Marsh, Boston; Nieman Marcus, Dallas; Dayton Co., Minneapolis; Bon Marche, Seattle; Nordstrom, Seattle; Gimbles, Milwaukee; and Carson Pirie Scott & Co., Chicago.

5.3 The total sales of Famolare in fiscal (November 1 through October 31) 1973, the last full fiscal year before Famolare introduced its "Get There" shoes, were $12,000,000. In fiscal 1974, which only included about three months sales of Famolare's "Get There" shoes, they were $15,000,000. In fiscal 1975, the first full fiscal year which included sales of Famolare's "Get There" shoes, they were about $20,000,000. More than half of Famolare's total sales in 1975 of about $20,000,000 were attributable to the "Get There" shoes. In fiscal 1976, sales were about $30,000,000, about 50% of which represented sales of "Get There" shoes; and, in fiscal 1977, about $40,000,000, again about 50% were "Get There" shoes. Famolare's sales in fiscal 1978 totaled about $70,000,000, of which $30,000,000 were sales of "Get There" shoes.

5.4 So-called "fads" in shoe styles peak out in three years or less and, typically, sales of "fads" will peak out after only one year. Sales of Famolare's "Get There" shoes have increased every year since introduction in 1974 and continue to move upward. The "Get There" shoes are the best selling shoes that Famolare has ever had in both numbers of units sold and in dollar volume.

5.5 The undisputable commercial success of Famolare's "Get There" shoes cannot be attributed merely to promotional and advertising expenditures. Substantial sales to retailers were made before Famolare initiated any advertising programs. Moreover, the expenditures by Famolare to promote and advertise the "Get There" shoes are in line with trade custom.

5.6 A significant part of the shoe industry has paid Famolare the ultimate compliment—the flattery of imitation. USM, by

copying the soles of Famolare's "Get There" shoes, has sought to capitalize on Famolare's success in the retail marketplace. The Court has also examined shoes manufactured and offered for sale by, for example, Edison, SCOA and Melville which are identical to the Famolare "Get There" shoe or so nearly so that it is apparent they have been copied.

6. The Shoe Industry

6.1 Like many other businesses, the shoe industry has its own customs, traditions and practices that have evolved over the years. It has long been a shoe industry custom, for example, for commercial transactions to be carried out through the public presentation, display and exhibition of samples. Shoe retailers, designers, manufacturers, and buyers, for example, customarily attend various national and regional shoe shows. Their express purpose in attending such shows is to examine, sell, offer to sell, promote, select or purchase shoes or soles.

6.2 The commercial process typically begins with the design or selection of a shoe line that is customarily made up of shoes of various designs, colors, styles and prices. Oftentimes a line is then introduced at a shoe show where samples are shown, publicly displayed and offered for sale. The whole purpose of a shoe show is to display samples and sell shoes.

6.3 Not all the shoe samples that are publicly shown or offered for sale at a shoe show are produced in large-scale quantities. In some cases, for example, if orders for less than 20,000 pairs are taken at a single show, the samples may be sold and either dropped from the line or reintroduced at a later date.

6.4 Timing, however, is often more important than the intrinsic merit of a shoe design in determining whether or not a particular shoe, in fact, goes into production. Shoes like other fashion oriented products can be out of phase with a particular fashion trend, and thus appear to be unsuccessful one year and become highly successful 2, 3 or 12 years later.

6.5 The success or failure of a particular shoe style, therefore, is not necessarily an accurate barometer of the merit or lack of merit of that particular shoe design, since its success or lack of success is dependent upon a myriad of factors such as color, comfort, timing, fabric, price and promotion. Moreover, in the case of a sole rather than a completed shoe, shoe upper design, style, color or trim, may, and often does, play a significant role in the degree of commercial success that a sole may achieve.

7. The Background of USM and Edison Regarding the Manufacture and Sale of the Accused Soles

7.1 Mr. John P. Rooney is, and has been, the General Manager of USM's Premolded Sole Division since about January 1, 1975.

7.2 Mr. Rooney purchased a pair of Famolare "Get There" shoes at the Jordan Marsh department store in Peabody, Massachusetts in January 1975.

7.3 These shoes were purchased as a result of a conversation with either Mr. Bob Gallant of Jo-Gal Shoe or Mr. Jack Jones of Hiatt Shoe.

7.4 Mr. Rooney was aware of the Benetti sole and the Ran sole prior to the time that USM commenced the manufacture of soles accused of infringement by plaintiffs.

7.5 By a letter dated February 24, 1975, Famolare's patent counsel, Mr. Michael Cornman of Mandeville & Schweitzer, New York, informed USM of Famolare's intent to enforce its alleged proprietary rights in certain multiwave construction soles and shoes incorporating such soles. This letter was received by USM's Patent Department on February 28, 1975.

7.6 A meeting was held at Famolare's New York, New York offices on April 14, 1975. The following persons were in attendance:

For USM:

(1) Mr. John Rooney, General Manager of USM's Premolded Sole Division and

(2) Mr. Vincent White, an attorney in USM's Patent Department

For Famolare:

(1) Mr. Leo Famolare, Vice President of Famolare
(2) Mr. Carle Conway, Vice President of Famolare
(3) Mr. Michael Cornman, patent counsel for Famolare, and
(4) Mr. Fritz Schweitzer, Jr., patent counsel for Famolare.

7.7 The so-called Benetti sole was discussed at the April 14 meeting, and in addition, there was discussion of a sole, now identified as the "Ran" sole, that USM had made and which was alleged by USM to be "essentially the same" as the Benetti sole. At the meeting, USM sought and thereafter continued to seek a license from Famolare and during the meeting USM made it quite clear that they intended to make molds and soles regardless of Famolare's decision.

7.8 On or about May 20, 1975, in connection with the Utility Patent application Serial No. 499,493 which was still pending, an amendment was filed submitting the various patents and photographs which had been provided to Cornman by USM to the Patent Office. On May 22, 1975, Mr. Cornman spoke to Mr. White and reported that he had spoken to the Patent Office Examiner and made the art cited to him of record and that the Examiner had indicated that the Utility application would be allowed with claims that would cover the USM unit sole which they were proceeding with. (PTX-549).

7.9 During April and May, there were further contacts between USM and Famolare with USM still pursuing the possibility of obtaining a license from Famolare. (PTX-116-118)

7.10 USM continues to manufacture and sell some of the soles accused in the present lawsuit of infringing the patents in suit.

7.11 Edison has ordered, received and sold shoes with soles of the type accused in the present lawsuit since the spring of 1975.

8. Alleged Patent Infringement by USM

8.1 Famolare charges USM with infringement of its design and utility patents (U. S. Des. 235,701 and U. S. 3,936,956); Famolare does not charge USM with any acts of unfair competition or of infringement of any other proprietary rights.

8.2 Famolare charges USM with infringing the design patent in suit by manufacturing, using and/or selling the following shoe soles: PTX-24; PTX-27-34; and PTX-38-42, including PTX-40a.

8.3 Famolare charges USM with infringing and contributorily infringing one or more claims of its Utility Patent in suit by manufacturing, using and selling the following shoe soles: PTX-27-34 and PTX-42.

8.4 Famolare does not charge USM with infringement of either patent in suit as to the following shoe soles: PTX-357-66.

8.5 Some of the shoe soles manufactured and sold by USM that are accused of infringing Famolare's design patent in suit are made of synthetic polymeric materials such as Kraton.

9. Alleged Infringements by Edison

9.1 Famolare charges Edison with infringement of its design and utility patents in suit and with trademark infringement and unfair competition in violation of 15 U. S. C. § 1125, the trademark common law of Illinois, and the following statutes of the State of Illinois, S. H. A. Ill. ch. 140 § 22; S. H. A. Ill. ch. 140 §§ 23-28; and S. H. A. Ill. ch. 121½ §§ 311-17 as particularized in E. (a) and E. (b) below.

9.2 Famolare charges Edison with infringing its design and utility patents in suit, and with trademark infringement and unfair competition by reason of and in connection with its sale in the United States of shoes containing the following identified soles manufactured by USM: PTX-11, PTX-13 and PTX-16-19.

9.3 Famolare charges Edison with infringing its design and utility patents in suit, and with trademark infringement and unfair competition by reason of and in connection with its sale in the United States of shoes containing the following identified soles manufactured by entities other than USM: PTX-12, PTX-14-15, and PTX-20-22.

9.4 Famolare charges Edison with infringing its design (but not utility) patent in suit, and with trademark infringement and unfair competition by reason of its sale in the United States of shoes containing the following identified soles: PTX-23 and PTX-24.

9.5 Famolare does not charge Edison with infringement of either patent or with trademark infringement or unfair competition of any of the following soles: PTX-367-85 and PTX-25-26.

9.6 Pursuant to Rule 41(a)(2) F.R. Civ. P., Famolare has moved to dismiss with prejudice its trademark and unfair competition claims against Edison.

10. Prior Printed Publications and Prior Art

10.1 The following constitute publications printed prior to the inventions of the Famolare design and utility patents in suit:

Description	Exhibit No.
The Mode in Footwear—R. Turner Wilcox—1948	DX-19
Mitsubishi Boot—Footwear News, July 1, 1971	DX-88
Benetti Sole, Foto Shoe Magazine, April 1971	DX-97 and 98
"Bottoms In"—Footwear News, August 17, 1972	DX-115
Casadei—Footwear News January 25, 1973	DX-116
"Crepers"—Footwear News, August 10, 1972	DX-117
Casadei—ARS Sutoria Vol. 103 at p. 193, March 1973	DX-118
ARS Sutoria, Vol. 100 at p. 357, June 1972	DX-119
Moda in Pelle, June 1972 at p. 29	DX-175
Moda in Pelle, September 1973 at p. 47	DX-176
ARS Sutoria, 1971 at p. 73	DX-177
ARS Sutoria, June 1972 at p. 179	DX-178
ARS Sutoria, June 1972 at p. 313	DX-179
"Moving Sole," Footwear News, September 10, 1970	DX-191
ARS Sutoria, Vol. 110, 1972	DX-200
"Linardi, Moda Pelle", June 1973	DX-201

10.2 Defendants rely on seven physical items of alleged prior art, *i.e.*, actual shoes or soles. Some of these soles were

publicly used, sold or placed on sale in the United States more than one year before the filing dates of the Famolare patents. Others were known or used in the United States before Famolare's earliest effective date of invention or were contemporaneous therewith. None was a commercial success.

10.3 The Benetti sole was designed by a well known Italian shoe designer named Ivano Benetti. Mr. Benetti called on and actually offered to sell his shoe designs, samples and models to Famolare in their Italian offices as early as 1972. The Benetti sole was shown in the April 11, 1971 issue of Foto Shoe Magazine. In April 1971, 107 samples of shoes containing the Benetti sole were received on consignment by Benetti's Canadian representative, Mr. Jacques Pinsonneault, and were part of a collection that was shown to various shoe manufacturers in the United States in April 1971. Mr. Pinsonneault displayed, offered to sell and actually sold shoes containing the Benetti sole at the April 1971 Leather and Allied Shoe Show in New York, and in 1971 took samples of the Benetti shoe to various cities in the United States where they were presented, offered and actually sold to shoe companies as evidenced by invoices and related documents produced from his files.

10.4 The USM Ran Sole was made in May 1971 at the request of a USM customer, Howard Goodman. A mold for the sole was actually made and in existence in May 1971. Prices were discussed and a verbal quotation given to Mr. Goodman. Samples of the sole were sued [sic] by USM, shown at trade shows and offered for sale in 1971.

10.5 The Hlustik sole was actually sold in the United States in 1971. In November 1971, forty pairs of Hlustik soles were purchased by the Desco Shoe Company. Between January 20, 1972 and May 1972, between 72 and 75 pairs of Hlustik soles were received by Desco. A number of commercial boots were made by Desco in January and February 1972. They were shipped to Desco's salesmen by March 1972, and were sold and offered for sale in the United States immediately thereafter.

Invoices, letters, mold drawings and an actual sample sole corroborate these facts.

10.6 The Mitsubishi sole was part of a shoe collection that was designed by a shoe designer named Moya Bowler, shown and offered for sale in Mistsubishi's offices in New York in 1971, and promoted and described in a Footwear News article dated July 1, 1971.

10.7 The Super Stroller shoe was designed in Canada in March 1973. By July 1973, molds for the sole had been made in Italy by the same mold maker Famolare uses for its "Get There" soles. By late August or early September 1973, completed shoes containing the Super Stroller sole were taken to New York for public display and promotion in the showroom of Harbor Imports Company where they were offered for sale to shoe buyers.

10.8 The Zeni Onda sole was designed by a shoe designer named Astra Maccioni who carried out her design activities in Florence, Italy. The Zeni Onda sole was publicly shown and offered for sale by Carber Enterprises at a New York shoe show as early as January 27, 1974.

10.9 The Super Shoe Biz soles were "placed on sale" and "known or used in the United States" prior to May 28, 1973 and described in Footwear News in the August 10, 1972 issue.

10.10 Styrene-butadiene block copolymers, sold under the trade name "Kraton," have been used and/or were publicly known to be useful in the manufacture of shoe soles prior to May 1, 1973.

11. Famolare's Notice to the Trade

11.1 Beginning in early 1975, Famolare and its attorneys advised the industry in general and numerous individual manufacturers and sellers of shoes and shoe soles that Famolare had existing and pending proprietary rights in the four wave "Get There" shoe as well as in three and five wave soles and intended to enforce its alleged proprietary rights against infringers.

Numerous manufacturers and sellers of shoes and shoe soles responded by either discontinuing or terminating plans to make or sell certain shoes and shoe soles or by seeking indemnity from their suppliers such as USM, which has agreed to indemnify some 55 of its customers.

Conclusions of Law

1. Jurisdiction

1.1 This is a suit brought under the U. S. Patent Laws, Title 35, United States Code; the U. S. Trademark Laws, Title 15, United States Code; and the Illinois Trademark and Unfair Competition Laws, Chapters 121½ and 140. This Court has jurisdiction of the parties and of the subject matter of this action by virtue of U. S. C. §§ 1338 and 2201. Venue is proper as required by 28 U. S. C. § 1400(b).

2. The Design Patent

2.1 The design patent is invalid in that it lacks invention over the prior art and reflects no creative originality or artistry.

2.2 The design patent is also invalid in that it would have been obvious to a designer of ordinary skill to design soles with three, four, five or more waves.

3. The Utility Patent

3.1 The utility patent is invalid in that it represents no significant advance in shoe sole design and, therefore, involves no invention.

3.2 The utility patent is invalid because the claims are not sufficiently definite to meet the requirements of 35 U. S. C. § 112 in that they fail to inform either the specific structure or the limits of the claimed invention.

3.3 The utility patent is not invalid because it would have been obvious to one of ordinary skill in the shoe sole design art.

4. Plaintiff's Claim of Trademark Infringement and Unfair Competition

4.1 On plaintiff's motion, its claims of trademark infringement and unfair competition are dismissed with prejudice.

5. Defendants' Claims of Misuse, Unenforceability Under 28 U. S. C. §§ 2201-2 and unfair competition.

5.1 The Court does not reach or rule on defendants' claims of misuse, unenforceability under 28 U. S. C. §§ 2201-2 or unfair competition.

Opinion

I. Introduction

This case involves the validity and alleged infringement by defendants of two patents issued to Joseph P. Famolare, Jr., and assigned to plaintiff, United States Patent Des. 235,701 and United States Patent 3,936,956. In addition, plaintiff initially charged Edison with violation of federal and Illinois trademark and unfair competition laws but has moved to dismiss these charges with prejudice which it has the right to do. *Smoot* v. *Fox*, 340 F. 2d 301 (6th Cir. 1964). The defendants, on the other hand, have counterclaimed for a declaratory judgment of non-infringement, invalidity, misuse and unenforceability of the patents in suit pursuant to 28 U. S. C. §§ 2201-2 and for unfair competition under both federal and Illinois laws.

Both the design and utility patents relate to a shoe sole having a sinuous contoured bottom surface. Shoes manufactured with soles embodying the four wave version of the patented soles were first sold by plaintiff in 1974 and have enjoyed unusual commercial success with plaintiff's sales of shoes with four wave soles in 1978 representing almost half of its total sales of approximately $70,000,000. Moreover, the wavy sole design has been largely responsible for Famolare's sales increasing from $12,000,000 in fiscal 1973 to $70,000,000 in 1978.

No calculations of the sales of other manufacturers of copies of the four wave "Get There" shoe and other shoes with wavy soles have been introduced into evidence but USM has indemnified some 55 shoe manufacturers and sellers from claims of infringement by Famolare. The Court has, in addition, examined a number of shoes offered for sale by Edison, SCOA and Melville, the soles of which are either identical with or very close copies of the four wave "Get There" sole.

In this connection, Famolare has in the past contended that not only four wave but three and five wave soles as well infringed either or both of the design and utility patents.

II. The Design Patent

We deal first with the design patent No. 235,701, a copy of which is Appendix A hereto. The application was filed May 28, 1974 and the patent issued July 8, 1975. As indiciated in our Findings of Fact, it represents one of at least three wavy soles sketched by Joseph Famolare while flying from New York to London in the fall of 1973. Two other were for a three wave and a five wave sole. Models of each were made after Mr. Famolare reached Italy and sample shoes with the four wave soles were assembled in time for them to be exhibited at the March 1974 Chicago Shoe Show at McCormick Place where they were first offered for sale. Since that time, they have enjoyed increasing commercial success and have been widely copied by defendants and others.

As plaintiff now apparently concedes, the design patent cannot possibly apply to any sole other than the four-wave version represented therein. By its terms, it covers "The ornamental design for a shoe sole, substantially as shown and described," and the only embodiment shown is a four wave sole with very slight crests and hollows. The various attempts to charge sellers of three and five wave soles with infringement were clearly inappropriate.

Defendants contend that the design patent is invalid because the four wave sole is neither new, original, ornamental or non-obvious but is "merely different" than the prior art, as evidenced by seven examples thereof. Silhouettes of the five most similar, the Super Stroller, Benetti, USM Ran, Zeni Onda and Hlustik soles, are attached hereto as Appendix C. All were designed in the early '70s, confirming the testimony of several witnesses that shoe designers were seeking and experimenting with wavy soles at that time.

Plaintiff's counsel has colorfully described defendants' prior art as a "chthonian assemblage of departed soles, resurrected from a limbo of aborted designs" and it is correct that none achieved commercial success while plaintiff's four wave "Get There" shoe has enjoyed great commercial success. It should be noted that plaintiff's three and five wave sole shoes have enjoyed less commercial success although more than any of the asserted prior art. It should also be noted that, in designing the wavy sole bottoms, Mr. Famolare was aiming at the young female market and the majority of the shoes embodying his wavy soles are sold to that group although women's and men's models are also on the market.

Shoe designing, particularly of women's and young women's shoes, is a fashion industry and Joseph Famolare has been recognized as a leading shoe designer by being included in the recently published "The Fashion Makers" by Bernadine Morris, fashion editor of the New York Times and fashion photographer Barbara Walz. Miss Walz testified at the trial that she owns seven pairs of "Get There" shoes and considers them both very fashionable and very comfortable.

Historically, fashions are cyclical whether in clothes, shoes or other fashion items. They come, go and return to repeat the cycle. The most common examples are the length and style of ladies fashion dresses. The duration of the cycles varies depending on a number of factors and the dispute as to whether

the fashion designers or the consumers determine changes in fashions will undoubtedly never be resolved since, apparently, the former regularly propose new designs, some of which are accepted by consumers while the majority are rejected.

Historically also, design patents in the fashion field have been rare. Imitations and copying are commonplace and well-known fashion designers make no effort to patent their new creations, hoping simply to set the new fashion style with them and thereby enhance their own sales and reputations but recognizing that imitations and copies will make their appearance almost immediately. The only protection which they possess is that the imitators may not pass their copies off as creations of the originator.

The Famolare wavy sole shoes, particularly the four wave "Get There," have enjoyed increasing acceptance since their introduction in 1974 which may evidence that they will enjoy a longer cycle than usual as did, for example, the so-called "Earth" shoe, or that the wavy soles may possibly become standard along with the traditional flat sole and heel design. In any event, their continued acceptance has caused defendants and others to copy them in an effort to capitalize on their popularity. Famolare, in turn, has sought through various means including notices of infringement, threats of suit and five or six actual suits in jurisdictions ranging from New York to Hawaii, to establish a proprietary interest in all wavy soles and either to prevent others from making or selling them or to collect substantial royalties. As previously indicated, the attempt to extend the design patent to other than four wave soles was unwarranted.

Against this background, we come to the validity of the design patent. Both sides agree that the standard for validity of both design and utility patents is invention and that invention in design is measured by whether it is new, original, ornamental and non-obvious. Plaintiff urges that this must be determined

by the whole invention, its overall aesthetic effect, the "tout ensemble" citing *Gorham Company* v. *White*, 14 Wall 511 (1871), *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966), and *Pelouze Scale and Mfg. Co.* v. *American Cutlery Co.*, 102 Fed. 916 (7th Cir. 1900).

It also urges that invention is evidenced by commercial success, "the reception which those for whom it is made accord it." *Standard Match Corp.* v. *Bell Machine Co.*, 83 F. 2d 365, 367 (7th Cir. 1936). Finally, plaintiff contends that the widespread copying by defendants and others is also evidence of invention, citing *Sel-O-Rak Corp.* v. *The Henry Hanger & Display Fixture Corp.*, 232 F. 2d 176 (5th Cir. 1956).

Defendants, on the other hand, urge that invention in the design field must involve more than mere changes in detail and may not simply be a new combination of old features even though producing a different artistic effect, citing *Frantz Mfg. Co.* v. *Phenix Mfg. Co.*, 457 F. 2d 314 (7th Cir. 1972). They further contend that neither commercial success nor the fact that the design has been widely copied establishes invention if the dominant features are found in the prior art and the new combination does not exhibit creative originality beyond the skill of an ordinary designer working in the art, citing *Amerock Corp.* v. *Aubrey Hardware Mfg., Inc.*, 275 F. 2d 346 (7th Cir. 1960); *Hopkins* v. *Waco Products*, 205 F. 2d 221 (7th Cir. 1953); *Associated Plastics Cos.* v. *Gits Molding Corp.*, 182 F. 2d 1000 (7th Cir. 1950); *S. Dresner & Son, Inc.* v. *Doppelt*, 120 F. 2d 50 (7th Cir. 1941).

In support of their respective positions, each side at trial called persons knowledgeable in the shoe and design fields as expert witnesses. The plaintiff's experts included two executives of large shoe retailers and an importer of shoes, the exclusive U. S. agent of Salvatore Ferragamo, a well-known Italian shoe manufacturer. All were of the opinion that Famolare's "Get There" sole design was unique and new. One of the re-

tailers originally bought it for its attractive look, the other thought it was so different in appearance from traditional shoes and soles that "it was a real turkey" and bought it only because of Famolare's reputation and urging. Both testified that the "Get There" shoe has been the best selling shoe they have ever sold.

Defendants' trial experts included two designers, one a recognized industrial designer, Walter Dorwin Teague, but who has had little experience in the shoe field, and the other, David Menken, an experienced shoe designer and shoe importer. Both pointed out that, in their opinions, all of the essential features of the Famolare shoe sole were old in the shoe sole art and, while the combination is slightly different than previously achieved, it is well within the skill of an ordinary designer having the prior art before him. As they see them, the essential elements are a wedge shaped sole, an undulated bottom, a raised toe and a rounded heel.

Without doubt, those features in general terms are not new to shoe sole design. On the other hand, the effect or appearance of the Famolare four wave sole is different than any of the prior art with the Canadian Super Stroller being most similar. See Appendix C. It was developed some six or seven months before Famolare's in-flight sketches were made and sample shoes with the Super Stroller sole were exhibited in New York in August or early September 1973. Whether Mr. Famolare saw them before his flight to London during which he sketched his three, four and five wave soles is not reflected in the record.

If difference in appearance from the prior art, commercial success and widespread imitation and copying add up to invention, the Famolare design patent is valid. If, however, a design patent to be valid must reflect "creative originality in artistry" (*Amerock Corp.* v. *Aubrey Hardware Mfg., Inc., supra* at 348), it can hardly be contended that the Famolare wavy soles represent a revolutionary concept in shoe sole design. As early as 1948, shoe soles with uneven bottoms were disclosed in trade

publications. The Hack design patent '676 was issued in 1953 for a closely rippled sole. In the early '70s, as previously indicated, a number of shoe designers presented various wavy or undulating soles. Apparently, Famolare's was the most attractive as well as being comfortable with the result that it is the most successful and the most widely copied.

As previously pointed out, it has been recognized for many years that new designs in the apparel industry, for example, are rarely patentable given the requirement that their creation reflect "some salient ability." *Nat Lewis Purses, Inc.* v. *Carole Bags, Inc.*, 83 F. 2d 475, 476 (2d Cir. 1936). In that case, Judge Learned Hand suggested that perhaps fashion designers ought to be given a limited copyright. Congress has considered the matter on a number of occasions, most recently in connection with the Copyright Act of 1976, Title II of which, as passed by the Senate, provided for a five year, renewable to ten years, copyright for "original ornamental designs of useful articles." Title II was opposed by the Department of Justice on the ground no showing had been made that the benefits of such a monopoly would outweigh the disadvantage of removing new designs from free public use. The House of Representatives committee deleted Title II, in part because it "could not truly be considered copyright protection" and because, in light of Justice's objections, the Committee believed further study was necessary.

It is not our province to decide if some protection is necessary or desirable for creators of new fashion designs. As reflected by plaintiff's almost meteoric commercial success, creative designers whose creations "catch on" do benefit substantially from public acceptance of their work. On the other hand, as reflected by defendants' performance in copying and selling substantial numbers of similar shoe soles and shoes, less creative units in the fashion industry get a "free ride" unless the design is so novel and unique that it meets the high standard of invention now required which is very difficult to do in the field of fashion design. Meanwhile, the public has the choice of buying the

creator's product, which is usually more expensive and frequently of better quality, or one of the copies.

Given the present state of the patent law, the relevant prior art and the relative variation thereof reflected in plaintiff's patent, we conclude that, while the plaintiff's four wave "Get There" sole is the best wavy shoe sole design developed to date, has been an outstanding commercial success, and has been widely copied by a number of competitors including defendants, it does not represent such an inventive contribution to the public or such a meaningful advance in the shoe design art that it constitutes invention.

We also conclude that, as defendants' experts, including other shoe designers, opined, the variations or modifications between the prior art and Mr. Famolare's wavy soles including the four wave sole which is the subject of the design patent are not so substantial that they would be beyond the skill of ordinary designers working in the shoe design art. As the record indicates, Famolare designed and his company has sold three, four and five wave soles with the four wave being the most popular. It is without doubt a very successful design but it is not invention.

Accordingly, we find United States Patent Des. 235,701 invalid for lack of invention.

III. The Utility Patent

The utility patent No. 3,936,956, Appendix B hereto, was issued February 10, 1976 on an application filed August 22, 1974. It contains 19 claims, only three of which are independent and only two of which, Claims 1 and 7, are relied upon by plaintiff here. Claim 1, the basic claim, reads as follows:

> "1. A reflex action one-piece sole for shoes, which comprises
>
> a. a longitudinally extending thick body of resilient, shnock [sic] absorbing material;

> b. said body including generally horizontal upper surfaces, an edge wall having front, side, and rear portions, and a bottom surface;
>
> c. said bottom surface comprised of alternating crests and troughs extending completely there-across and being generally perpendicular to the longitudinal axis of said body;
>
> d. said crests including spaced, lowermost ground contacting portions;
>
> e. said alternating crests constituting in succession, a forwardmost toe crest, an intermediate ball crest, an intermediate shank portion crest, and a heel crest, the lowermost ground contacting surfaces of the latter three crests lying in a substantially common plane;
>
> f. said forwardmost toe crest being elevated with respect to the remainder of said crests and extending forwardly toward and terminating at front edge portions of said sole to provide a rolling, thrusting action as the sole is progressively engaged with a ground surface in walking; and
>
> g. said heel crest extending upwardly and rearwardly toward and terminating in said rear edge portions of said sole to provide an initial rolling action as the sole is progressively engaged with a ground surface in walking;
>
> h. said sole thereby providing a gentle rocking motion as it progressively contacts a ground surface."

It is clear from the record that, as the four wave "Get There" sole became more widely worn, Famolare discovered that he had developed a comfortable as well as a commercially attractive sole design. It is also clear that the original design was dictated by stylistic not anatomical considerations although, as Mr. Famolare testified, a designer necessarily has to be concerned that his resulting product will be functional and he ultimately selected the four wave sole to be presented first because he believed it to be not only the most aesthetic but functional as well.

Persuaded that the wavy sole design, and particularly the four wave version, had unique functional characteristics and being desirous of securing as much patent protection as possible, Joseph Famolare filed for a utility patent in August 1974. Apparently without a clear understanding of the anatomical factors which plaintiff's expert, Dr. Philip R. Brachman, delineated at the trial, Mr. Famolare and his patent attorney explained his invention as "a new and improved contoured sole . . . which enhances in a positive manner, by a reflex action, the striding movement of the wearer." (Col. 1, lines 41-44) This was achieved, he asserted, by "A generally wedge-shaped sole . . . with a bottom surface configured to enhance and to generate the body movements of the wearer from the moment the heel is placed on the ground or other supporting surface to the time the toe leaves the ground in a striding action." (Col. 1, lines 44-49) The bottom surface was described as "a series of alternating ground contacting crests and troughs which give the sole a free-flowing, wave-like appearance." (Col 1, lines 58-61) The rearmost crest in the heel portion "gives the wearer a roll-like head start . . . in this stride during the initial impact with the ground or other supporting surface. Moreover, it absorbs impact shock. The second crest imparts a slight thrust to the wearer in the arch region of the foot during rolling placement, . . . serves to generate a further forward propulsion force during the stride, and also absorbs impact shock." (Col. 1, line 62; Col. 2, line 3)

"The third crest at the ball of the foot," Mr. Famolare asserted, "impacts with the ground at the peak of the stride, and enhances the generation of forward momentum." And the "fourth and final crest at the toe of the shoe is elevated above the general surface plane of the other crests and provides a rolling finish for the stride, and develops a positive, determined forward thrust for the commencement of the next step in the walking action." (Col. 2, lines 4-11)

In addition to its contribution to walking, "in moments of standing, the continuously curved contour of the bottom surface

of the sole . . . initiates a positive rocking action, which serves to stretch the front and back muscles of the leg and improves the muscle tone thereof." (Col. 3, line 66; Col. 4, line 3)

Plaintiff's expert, Dr. Philip R. Brachman, a nationally recognized podiatrist who has been on the faculty of the Illinois College of Podiatric Medicine since 1934, explained the anatomical reasons why, in his opinion, the four wave "Get There" sole is exceptionally comfortable, reasons considerably different than those described in the patent. Dr. Brachman, incidentally, wore a pair of "Get There" shoes with the four wave sole for two months and found them excellent.

His conclusion was that the four wave Famolare sole is unusually comfortable because the four wave crests are placed at the four points of the foot which bear weight in walking and the troughs coincide with the positions of the foot through which the nerves, blood vessels, etc. pass and which, while they require support, are not weight bearing.

All experts on both sides agreed that there are four normal weight bearing locations of the foot and that this has been well known for many years. They also agreed that these four points are the heel, the shank, the ball and the toes. Finally, they agreed that any sole, if it is to be wearable, must support the four weight bearing points.

On the other hand, there is sharp disagreement among the experts as to whether or not the four wave "Get There" sole has beneficial effects in walking or if the structure of the utility patent is anticipated by the prior art or would have been obvious to one of ordinary skill in the art. Dr. Brachman believes the four wave sole is the nearest thing to barefoot walking he has seen in his forty-four years of podiatric practice while providing the support needed by the foot when walking on hard surfaces.

In contrast, defendants presented Dr. H. Joseph Scheuchenzuber, Jr., a member of the faculty of Springfield College, Springfield, Massachusetts, where he teaches graduate and under-

graduate courses in biomechanics and a graduate course in computer science. He is an expert in kinesiology, biomechanics and human motion. He conducted a series of scientific tests. His first conclusion was that walking barefoot is the most efficient way to walk both as to displacement of the center of gravity and kinetic energy variability. The tests, in his opinion, also demonstrated that the four wave "Get There" sole is not more efficient in walking than many conventional shoes. Specifically, he found that (1) it does not produce an inherent rocking motion while standing, (2) it has no measurable different effect on knee or joint action during walking, (3) it does not increase stride length and (4) it has little effect on the amount of muscular activity required in walking. Finally, he concluded that a Benetti sole (see Appendix C) made out of Kraton was substantially similar in joint action, muscular activity, stride length and general walking efficiency to an allegedly infringing USM four wave sole and was believed by his testers to be more comfortable. Incidentally, he also concluded that the "Earth" shoe which had a negative heel and enjoyed a relatively long cycle of popularity was not superior to conventional shoes.

We conclude that, while the four wave "Get There" shoe is functionally comfortable to a wearer for the reasons described by Dr. Brachman, it does not represent a significant advance in shoe sole design. The five crest Benetti (see Appendix C) apparently achieves similar results in function and comfort if Dr. Scheuchenzuber's findings are accurate, and we have no reason to doubt that they are. Moreover, it appears that all sole designs must necessarily support the four weight bearing portions of the foot if they are to be wearable.

Two of defendants' experts, Messrs, Teague and Menken, both stated with great assurance that, since the four weight bearing points of the foot are well known, it would have been obvious to anyone with ordinary skill in the art to place crests there in designing a wavy bottom sole. The short answer to that opinion is that none of the various designers of other wavy

bottom soles, Benetti, Hlustik, Maccioni, Bowler and others, created four wave soles with the crests placed under the four weight bearing points and Mr. Famolare appears to have done so more or less fortuitously in the process of designing three, four and five wave soles. It follows from the foregoing that the "Get There" four wave sole is not anticipated by the prior art nor was it obvious to those skilled in the shoe design art.

The question may be asked, "How, if the four wave sole would have been obvious to a designer of ordinary skill in the art for purposes of the design patent, is it not equally obvious for purposes of the utility patent?" The answer is that, while designing shoe soles with three, four, five or more waves and crests would be obvious to an ordinary skilled designer, the placement of each of four crests at the four weight bearing points of the foot apparently was not obvious to any designer including Famolare who was not aware of the anatomical significance of his four wave design until Dr. Brachman point it out. In fact, until the trial, Mr. Famolare believed and contended that three and five wave soles also infringed his utility patent.

Defendants also assert that the claims of the patent are not sufficiently definite to meet the requirements of the second paragraph of 35 U. S. C. § 112, which specifies that a patent

> ". . . conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

This statutory requirement has consistently been held to be mandatory with no exceptions for inventions that are difficult to describe specifically. The Supreme Court has stated the requirement and the reasons therefor as follows:

> "Recognizing that most inventions represent improvements on some existing article, process or machine, and that a description of the invention must in large part set out what is old in order to facilitate the understanding of what is new, Congress requires of the applicant 'a distinct and specific statement of what he claims to be new, and

to be his invention.' Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirement as to claims of invention or discovery.

* * * * *

"The inventor must inform the public during the life of the patent of the limits of the monopoly asserted so that it may be known which features may be safely used or manufactured without a license and which may not." *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U. S. 364, 368-69 (1937).

Defendants point out that plaintiff's expert, Dr. Brachman, as well as their experts, Messrs. Teague and Menken, could not determine the bounds of the invention from the utility patent's claims. Nor, they said, could they construct a "Get There" sole from the claims. Defendants contend that the claims are ambiguous and indefinite in a number of respects:

1) They fail to specify the precise number of crests and troughs on the sole bottom.

2) They fail to define the precise location of the crests in that the "shank" region of a shoe covers two points and the ball of the foot is diagonal running from the base of the large toe to the base of the little toe, while the claims call for crests running at right angles to the longitudinal axis of the sole.

3) They fail to specify the shape or dimensions of the waves in that they fail to specify the heights or base widths of the various crests or the depths of the troughs.

4) They fail to define the range of resilience or shock absorption of the material to be used as well as the relationship between the thickness and the degree or resilience or flexibility.

5) They fail to specify the degree of toe elevation.

6) They claim "a reflex action" without specifying how that can be achieved since neither the claims nor the specifications identify the four normal weight bearing points of the foot or the correlation of the crests therewith.

Plaintiff concedes that the specifics referred to by defendants are not to be found in the claims but urges that the claims are sufficiently precise to define the invention, pointing out that, while Dr. Brachman could not determine the limits of the invention, he had no difficulty identifying a number of four wave soles which, in his opinion, had crests located under the four normal weight bearing portions of the foot and, therefore, fell within the claims of the patent.

While conceding that the claims are not limited to four wave soles, plaintiff points out that both Claims 1 and 7 refer to heel, shank, ball and toe crests, and urges tha a proper construction of the two independent claims limits them to four wave soles with the crests located at the four weight bearing portions of the foot. In this connection, the specifications contemplate other than four waves for they read, col. 4 lines 30-43:

"[T]his invention is not limited to that particular arrangement, and, as will be appreciated and understood by those skilled in the art, changes may be made therein without departing from the scope of the invention which is defined in the appended claims. For example, the specific geometry of the sole may be modified or somewhat altered (in terms of proportions, number of crests and troughs, etc.) while maintaining the beneficial properties and characteristics of the illustrated sole by stretching the back of the leg and providing a distinct and positive forward thrust to the wearer in a general, 'free and flowing,' multiple waved manner."

It seems clear that the claims are not specific enough to define the invention so that a knowledgeable person could either build a sole embodying the invention or know its bounds in order to design around it. The best evidence of the latter fact is that, until very recently, the plaintiff and its patent counsel, Mr. Cornman, were contending that the patent covered three and five wave soles as well as four wave versions and without regard to where the crests were located or how shallow or deep they were.

The reasons for the ambiguity are fairly obvious. Mr. Famolare did not design an orthopedic sole; he designed one which he believed would be aesthetic and commercially attractive. He also believed it would be functional although he apparently also believes that the three and five wave soles are functional since his company sells them as well. Because he was desirous of obtaining broad patent coverage, he did not limit his patent to four wave soles. Subsequently, he learned that there may be an anatomical reason why the four wave sole is particularly comfortable. By then the patent had issued, however, not limited to four wave soles nor defining its structure in orthopedic or anatomical terms nor specifying the characteristics such as the height and width of the crests or the depth of the troughs.

As is apparent from an examination of the drawings of the design and utility patents (Appendices A and B), and the five other most similar soles (Appendix C), wide variations in height, width and depth are possible. There are obvious differences between the sole represented in the design patent and that shown in the utility patent, although they are basically similar. And the five others have either relatively sharp troughs and high crests as in the Benetti grading down in the height of the crest to the almost imperceptible Super Stroller and the rounded troughs of the Zeni Onda. No one reading the claims could determine the scope of Mr. Famolare's utility invention, if any, primarily because he did not intend to create a functional sole, did not discover until later that he had, and did not learn the reason for its functional effectiveness until after the patent had been granted. Under the circumstances, it is not surprising that the claims are ambiguous.

As indicated at the outset, defendants have counterclaimed for a declaratory judgment of non-infringement, invalidity, misuse and unenforceability under 28 U. S. C. §§ 2201-2 as well as unfair competition under both federal and Illinois laws. The record is clear that both defendants have made and sold soles or shoes, the soles of which were virtually exact copies of the

Famolare four wave "Get There" soles. Mere copying of an allegedly patented product does not necessarily constitute infringement unless the accused device falls clearly within the claims of the patent. Obviously, any three or five wave soles do not infringe the design patent and plaintiff does not now challenge them under the utility patent. On the other hand, certain of the four wave soles clearly do infringe the design patent.

So far as four wave soles infringing the utility patent is concerned, since the patent does not clearly define the structure of the sole covered, it is impossible to determine if any of the four wave soles infringe even though many of them are direct copies of plaintiff's soles sold commercially. In light of our finding that both patents are invalid, however, we deem it unnecessary to make a precise determination which of the four wave soles fall within the ambit of the design patent.

We likewise do not reach the issues of misuse, unenforceability under 28 U. S. C. §§ 2201-2 or unfair competition other than to observe in passing that the activities of plaintiff and its patent counsel in prosecuting the two applications in the Patent Office and in endeavoring to enforce and exploit the patents after, and even before, they issued, were not, in our experience, atypical although something less than noble and pure. Delaying action in the Patent Office; resolving doubts in favor of nondisclosure; stating claims as broadly as possible, even beyond the scope of the purported invention, so as to maximize coverage and to anticipate and forestall avoidance; amending the application to add claims, some of which involve new matter; in terrorem communications to putative infringers and competitors and their customers even before a patent issues; overstating the scope of an application, are all too common. Whether or not they exceeded acceptable limits in this case, we need not and do not decide.

The tactics of defendants were, of course, no more noble or pure. They purchased models of plaintiff's shoes after their

popular acceptance was established and simply copied them. At most, we have here pots calling kettles black.

We conclude as to validity that both patents are invalid for the reasons heretofore stated. The design patent lacks invention and it would have been obvious to any designer of ordinary skill to design soles with three, four, five or more waves. The utility patent involves a structure which functions very well but apparently not significantly better than a number of other soles. In addition, the claims are not sufficiently definite to meet the requirements of 35 U. S. C. § 112 in that they fail to inform either the specific structure or the limits of the claimed invention. Pursuant to its own motion, Famolare's trademark infringement and unfair competition claims will be dismissed with prejudice. A judgment consistent with all of the foregoing will enter.

/s/ Hubert L. Will
United States District Judge

Dated: March 30, 1979

FAMOLARE "GET THERE" AND THE PRIOR ART SOLES

"GET THERE"

"BENETTI" (DTX 105)

"HLUSTIK" (DTX 107)

"MITSUBISHI" (DTX 14A)

"RAN" (DTX 14)

"SUPER SHOE BIZ" (DTX 46)

"SUPER STROLLER" (DTX 12)

"ZENI ONDA" (DTX 83)

79-1451

REPRESENTATIVE USM SOLES AND EDISON SHOES

FILED
FILED
FILED

USM Soles

PTX 37A (WAVE)

PTX 40A (FLOW)

PTX 28 (BREAKER)

PTX 27 (W)

PTX 29 (FLOW)

PTX 31 (FLOW-X)

PTX 32 (MOLLY)

PTX 33 (WALI)

PTX 34 (LASI)

PTX 42 (ROLLING)

EDISON SHOES

PTX 22

PTX 14

PTX 25

PTX 23

Supreme Court, U. S.
FILED
MAY 13 1980
MICHAEL RODAK, JR., CLERK

No. 79-1692

IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

FAMOLARE, INC.,

Petitioner,

v.

EDISON BROTHERS STORES, INC. and USM CORP.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

RESPONDENTS' BRIEF IN OPPOSITION

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35 U.S.C. §171 9

CITATIONS IN THIS BRIEF

The citations in this brief are to the text of the petition for writ of certiorari (P. .....), to the petitioner's appendix integrally bound therewith (A. .....), or to respondent's appendix bound herewith (R. .....).

IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

FAMOLARE, INC.,

Petitioner,

v.

EDISON BROTHERS STORES, INC. and USM CORP.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

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RESPONDENTS' BRIEF IN OPPOSITION

Respondents, Edison and USM, agree that this Court has jurisdiction to consider Famolare's petition for writ of certiorari under 28 U.S.C. § 1254(1). The petition, however, presents no question meriting this Court's review.

This case involves no novel or disputed questions of law. Invalidity of both Famolare patents was established by the facts as found by the District Court. The decision of the District Court, after consideration of the record, was unanimously affirmed *per curiam* by the Court of Appeals. A petition for rehearing *en banc* was denied (R.

1). And, a motion to permit publication of the Court's unpublished order was denied on the ground, among others, that the case presented "no novel patent law questions and was decided in accordance with settled principles." (R. 2-3).

Moreover, the legal standard applied by both the District Court and the Court of Appeals is neither new nor controversial. It is the standard expressed in the Constitution and uniformly applied by this Court—patents cannot be granted for those things that neither add to the sum of useful knowledge nor advance the useful arts.

The petition for writ of certiorari should be denied.

REASONS FOR DENYING THE WRIT

The purpose of the patent system is not to provide certificates of merit for promotional achievement. Its purpose is to advance the arts and sciences by inducing inventors to disclose meaningful artistic or utilitarian achievements that will benefit the public.

As this Court observed in *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966):

> "Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of . . . useful Arts.' This is the *standard* expressed in the Constitution and it may not be ignored." (Emphasis in original)

Article I, Section 8 of the Constitution, therefore, sets the threshold standard for the grant of a patent. And

patents—whether directed to utility or design—cannot be granted where the effect of such a grant is "to remove existent knowledge from the public domain or to restrict free access to materials already available." *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 61 (1969).

THE DECISIONS BELOW ARE CONSISTENT WITH THE LEGAL STANDARDS APPLIED BY THIS COURT

Petitioner suggests that the law of design patents is in "total disarray" because this Court has not considered a design patent case since 1893. (P. 5). In truth, there has been no need for this Court's review. The last design patent case decided by this Court settled the matter. *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893). There the Court (quoting Mr. Justice Brown) found that the same standard existed for both design and mechanical patents,[1] and that:

> "To entitle a party to the benefit of the Act, in either case, there must be originality, and the exercise of the inventive faculty. In the one, there must be novelty and utility; in the other, originality and beauty. Mere mechanical skill is insufficient. There must be something akin to genius—an effort of the brain as well as the hand. The adaptation of old devices or forms to new purposes, however

[1] 148 U.S. at 679. More recently Mr. Justice Stevens (then Judge for the Court of Appeals for the Seventh Circuit) observed in *Frantz Manufacturing Co. v. Phenix Manufacturing Co.*, 457 F.2d 314, 327 (7th Cir. 1972):

> ". . . a patented design, like the subject matter of a mechanical patent, must embody invention. The purpose of the statute is to reward, and thereby to encourage, creative artistic activity rather than mere changes of detail which may produce 'novelty' but do not reflect 'invention'. The inventor must make a 'contribution to the public which the law deems worthy of recompense.' "

convenient, useful, or beautiful they may be in their new role, is not invention."

The District Court and the Court of Appeals not only used the proper standard of invention, as applied to the facts of this case, but they also properly interpreted the standard in view of the constitutional limitations that define the threshold conditions for patentability. The District Court concluded, after considering all of the relevant facts, that:

> "The design patent is invalid in that it lacks invention over the prior art and reflects no creative originality or artistry." (A. 32).[2]
>
> * * *
>
> ". . . it [the patented design] does not represent such an inventive contribution to the public or such a meaningful advance in the shoe design art that it constitutes invention." (A. 40).

The Court of Appeals affirmed the correctness of that conclusion:

> "There is, meanwhile, no question that the issue of invention, properly understood (as it was below), remains relevant to consideration of patent validity." (A. 8-9).

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[2] Petitioner conceded below that "the standard of validity of both design and utility patents is invention and that invention in design is measured by whether the design is new, original, ornamental and non-obvious." (A. 36). Every decision of this Court since *Graham* has confirmed that "invention" is still the ultimate constitutional and statutory test of patentability. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 at 61 (1969) (". . . those matters without invention will not make patentability."); *Dann v. Johnston*, 425 U.S. 219 at 225 (1976) ("As a judicial test, 'invention'—*i.e.*, 'an exercise of the inventive faculty, . . . has long been regarded as an absolute prerequisite to patentability.'"); *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 at 279 (1976) ("It has long been clear that the Constitution requires that there be some 'invention' to be entitled to patent protection.").

Petitioner's patents simply did not measure up to the exacting standard of invention the law requires. Hence, they were held invalid.

Lack of invention, however, was not the only basis for invalidity. Petitioner's design patent was also held invalid on the ground that the patented design "would have been obvious to a designer of ordinary skill" in the art. (A. 32). That further standard of patentability, as codified in 35 U.S.C. § 103, was likewise not met by Petitioner's design.[3]

The District Court's meticulous consideration of both the overall aesthetic effect of Petitioner's shoe sole design—the *tout ensemble*—and the individual design elements that make up the whole is evident from the record. (A. 9). The evidence before the District Court not only demonstrated that all of the essential features of the patented sole design were old, it conclusively established that the combination itself, while slightly different than previously achieved, was still "within the skill of an ordinary designer having the prior art before him." (A. 38).

Gorham Mfg. Co. v. White, 81 U.S. 511 (1872) does not mandate any different analysis of the obviousness issue. Indeed, as various courts have observed, the question of

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[3] Even a casual review of the prior art shoe soles illustrated in Petitioner's Appendix demonstrates why the legal conclusion of obviousness is inescapable. The scope Petitioner attributed to its design patent (which by law sets the bounds for determining validity) included soles with three, four or five undulations, soles with or without side ornamentation, and even soles with sculptured sides and flat bottoms (A. 27, 34 and 36). When the scope attributed by Petitioner to its own patent is compared to the prior art soles, there is, in fact, no difference between the patented sole and the prior art, much less a non-obvious difference.

invention was not an issue in *Gorham* because the matter reached this Court with invention conceded. *In re Stirling*, 47 F.2d 809, 811 (C.C.P.A. 1931); *S. Dresner & Son, Inc. v. Doppelt*, 120 F.2d 50, 51-52 (7th Cir. 1941).

This Court's decision in *Whitman Saddle*, decided eleven years after *Gorham*, is the controlling authority on design patent validity. And *Whitman Saddle*, like the decisions of the courts below, requires something more than the mere rearrangement of old components to justify the grant of a valid design patent (148 U.S. at 679).[4]

Neither the District Court nor the Court of Appeals departed from the time-honored standards that this Court has repeatedly held to be appropriate for determining design patent validity. There simply is nothing here to merit the Court's review.

NO CONFLICT EXISTS BETWEEN THE CIRCUITS

Petitioner asserts that a confict exists among Circuit Courts on the significance of commercial success and copying in deciding the issue of patentability for designs. (P. 15-16). This Court held in *Graham* that matters such as commercial success are at best secondary considerations of patentability that may have

[4] Literal application of Petitioner's *tout ensemble* rationale to the issue of design patent validity would eliminate the statutory requirement of non-obviousness entirely. Under *Graham*, an analysis of the obviousness issue requires a factual determination of the differences between the claimed invention and the prior art (383 U.S. at 17). Absent an objective analysis of the component parts of a design that make up its whole, there would be no means of determining what, if any, differences exist between the prior art and the patented design.

relevance in some cases (383 U.S. at 17-18). But every decision of this Court since *Graham* has made it clear that commercial success and other secondary factors "without invention will not make patentability." *Anderson's-Black Rock*, 396 U.S. at 61; *Dann*, 425 U.S. at 230, n.4; *Sakraida*, 425 U.S. at 282-83.

Here, both the District Court and the Court of Appeals considered Petitioner's evidence of commercial success and copying and found it unpersuasive on the ultimate issue of validity. Why? Because Petitioner's design lacked invention and was obvious in view of the prior art.[5] No decision of this Court or any Circuit Court requires more.

Moreover, there appears to be uniformity, not conflict, among the circuits in applying the strict constitutional and statutory standards of patentability for design patents. The Second Circuit has insisted that the design reflect "some exceptional talent beyond the skill of the ordinary designer," and candidly recognizes that "to obtain a valid design patent is exceedingly difficult." *G. B. Lewis Company v. Gould Products, Inc.*, 436 F.2d 1176, 1178 (2nd Cir. 1971). The Sixth Circuit requires that a new design must "represent a step which has required inventive genius beyond the prior art." *Thabet Mfg. Co. v. Kool Vent Metal*

[5] The evidence before the District Court conclusively demonstrated that shoes become popular and successful for a myriad of reasons—fashion, timing, upper design, color, fit, fabric, comfort, price, advertising and promotion. (A. 24-25). Since Petitioner presented no evidence that would show that the success of its shoes was attributable to the aesthetic appeal of its shoe sole design, rather than the extraneous factors, the District Court and the Court of Appeals found that success or failure of a particular shoe style did not serve as an accurate barometer of the merit or lack of merit of a particular design. (A. 10, 11, 24-25).

Awning Corp., 226 F.2d 207, 212 (6th Cir. 1955). The Tenth Circuit requires that a patented design "must not only be new and pleasing enough to win acceptance in the market place, it must also distinctly add to the total knowledge of the particular field of design . . . ." *Moore v. C. R. Anthony Co.*, 198 F.2d 607, 609 (10th Cir. 1952).

It is true, of course, that the history of design patents that reach the Courts of Appeal is replete with examples of designs that did not meet the required constitutional and statutory standards of patentability. That does not mean, however, that the established standards are either incorrect or should be discarded.[6]

THE ISSUE PRESENTED BY PETITIONER IS NOT IMPORTANT ENOUGH TO WARRANT REVIEW BY THIS COURT

Petitioner also suggests that this Court should grant certiorari in a design patent case every so often just as a matter of general principle—implying that the design patent law is not working as the Constitution requires and the Congress intended. (P. 5).

Respondents believe that the absence of any decisions by this Court in the design patent area since *Whitman Saddle* evidences the fact that the patent law is

[6] The statistics contained in footnote 10 of the Petition hardly establish the proposition that the Seventh Circuit is a uniquely dangerous forum for design patents (P. 7). Petitioner's figures show that only the Third Circuit has found more than one design patent valid since 1948, while the Second, Fourth, Fifth, Sixth, Ninth and Tenth Circuits have each found only one design patent valid. The First, Seventh, Eighth and D.C. Circuits have found none valid since 1948. These statistics suggest neither a meaningful difference in approach between the Circuits, nor a departure from the established standards.

functioning exactly as Congress intended and the Constitution requires. Those designs that meet the constitutional and statutory standard are found valid. Those that do not are found invalid. Changing the standard, as Petitioner suggests, by eliminating the statutory requirements of originality[7] and non-obviousness, or by ignoring the constitutional prerequisites of innovation, advancement and public benefit, is certainly not justified by the facts in this case.

This is a routine patent case that was decided on its facts, with no novel or important points of law at issue. This case does not merit this Court's review, and the petition for writ of certiorari should be denied.

[7] Petitioner is critical of the use of the term "creative originality in artistry." (P. 10-12). "Originality", however, like novelty, ornamentality and non-obviousness, is an express statutory requirement for the grant of a design patent. 35 U.S.C. § 171.

CONCLUSION

For the reasons stated above, Respondents respectfully request that the petition for writ of certiorari be denied.

Respectfully submitted,

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May 12, 1980

APPENDIX

UNITED STATES COURT OF APPEALS
For the Seventh Circuit
Chicago, Illinois 60604

February 29, 1980.

Before

Hon. THOMAS E. FAIRCHILD, *Chief Judge*
Hon. WALTER J. CUMMINGS, *Circuit Judge*
Hon. PHILIP W. TONE, *Circuit Judge*

FAMOLARE, INC.,

Plaintiff-Appellant,

No. 79-1451 vs.

EDISON BROTHERS STORES, INC. and
USM CORPORATION,

Defendants-Appellees.

Appeal from the United States District Court for the
Northern District of Illinois, Eastern Division.
No. 75C 2708—HUBERT L. WILL, *Judge.*

ORDER

On consideration of the petition for rehearing and suggestion for rehearing *en banc* filed in the above-entitled cause by plaintiff Famolare, Inc., no judge in active service has requested a vote thereon, and all of the judges on the original panel have voted to deny a rehearing. Accordingly,

IT IS ORDERED that the aforesaid petition for rehearing be, and the same is hereby, DENIED.

UNITED STATES COURT OF APPEALS
For the Seventh Circuit
Chicago, Illinois 60604

March 18, 1980.

Before

Hon. WALTER J. CUMMINGS, *Circuit Judge*
Hon. PHILIP W. TONE, *Circuit Judge*
Hon. .....

FAMOLARE, INC.,

Plaintiff-Appellant,

No. 79-1451 vs.

EDISON BROTHERS STORES, INC. and
USM CORPORATION,

Defendants-Appellees.

Appeal from the United States District Court for the
Northern District of Illinois, Eastern Division.
No. 75-C-2708—Judge HUBERT L. WILL.

This matter comes before the court for its consideration upon the following documents:

1. The "APPELLANT'S MOTION UNDER CIRCUIT RULE 17 FOR STAY OF MANDATE" filed herein on March 4, 1980 by counsel for the plaintiff-appellant.

2. The "MOTION TO PERMIT PUBLICATION OF UNPUBLISHED ORDER" filed herein on March 3, 1980 by counsel for the defendants-appellees.

3. The "RESPONSE TO APPELLEES' MOTION TO PERMIT PUBLICATION OF UNPUBLISHED

ORDER" filed herein on March 12, 1980 by counsel for the plaintiff-appellant.

This case presents no novel patent law questions and was decided in accordance with settled principles. Accordingly,

IT IS ORDERED that the motion for stay of mandate is hereby DENIED.

IT IS FURTHER ORDERED that the motion to permit publication of the unpublished order of this court is hereby DENIED.

Supreme Court, U. S.
FILED
MAY 21 1980
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-1692

FAMOLARE, INC.,

Petitioner,

vs.

EDISON BROTHERS STORES, INC. AND
USM CORP.,

Respondents.

REPLY TO RESPONDENTS' BRIEF IN OPPOSITION.

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May 20, 1980

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-1692

FAMOLARE, INC.,

Petitioner,

vs.

EDISON BROTHERS STORES, INC. AND USM CORP.,

Respondents.

REPLY TO RESPONDENTS' BRIEF IN OPPOSITION.

The same Constitutional standards and statutory conditions for patentability are applicable to design and utility patents alike. Petitioner has certainly acknowledged that proposition and does not suggest to this Court that it need depart therefrom in order to correct the error of the courts below. Yet there is a gnawing awareness by almost every judge and lawyer that has focused on the issue that the attributes and manifestations of non-obvious ornamental design inventions are inherently different from those of non-obvious mechanical, electrical and chemical inventions. The question is not *whether* to apply the principles of *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966), to design patents, but *how* to apply them.

The district court opinion below, almost fortuitously, provides a reference by which to evaluate the Seventh Circuit's approach to design patentability. For after it held the design patent

invalid as obvious over the asserted prior art, it held a utility patent directed to the same shoe sole design non-obvious over that very prior art, invalidating it on other grounds. The district court itself referred to that glaring incongruity ("The question may be asked . . ." A 45). And the Seventh Circuit mused over "the paradox inherent in finding the design patent obvious while finding the utility patent non-obvious" (A 11).

Petitioner submits that this "paradox" evidences an error of law resulting from the application of an improperly severe standard for design patentability, viewed both on an absolute scale and, in this unique case, by comparison with the utility patent standard. The necessary lowering of the Seventh Circuit's design standard is simply to bring it into conformance with the Constitution, section 103 and five other circuits.

CONCLUSION.

The Petition for Certiorari should be granted.[1]

Respectfully submitted,

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MARK E. PHELPS,
Attorneys for Petitioner.

May 20, 1980

1. By way of clarification rather than reply, petitioner notes that Plaintiff's Trial Exhibit 586 entitled "Representative USM Soles and Edison Shoes" and included at page A 52 of the appendix to the petition contains three items not charged at trial with infringement of either Famolare patent. These are PTX 37a (Wave), PTX 42 (Rolling) and PTX 25. As explained in paragraphs 6.7 and 9.6 of the final pre-trial order, exhibits 37a and 25 would have been charged with infringement had they been made or sold after the issuance of either patent. A charge of design patent infringement relative to PTX 42 was withdrawn at trial.